

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**CUSTOMER NO. 22927**

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TESTING

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Examiner: VAN BRAMER, John W.

**APPEAL BRIEF**

**BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Mail Stop: Appeal Brief  
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Appellants hereby appeal to the Board of Patent Appeals and  
Interferences from the decision of the Examiner in the Final Office Action  
mailed June 30, 2006 (Part of Paper No. / Mail Date 20060614).

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## **REAL PARTY IN INTEREST**

The present application is assigned to Walker Digital, LLC, Two High Ridge Park, Stamford, CT 06905.

## **RELATED APPEALS AND INTERFERENCES**

No interferences or appeals are known to Appellants, Appellants' legal representative, or assignee, which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

## STATUS OF CLAIMS

Claims **1 – 43** are pending in the present application.

Claims **1 – 37** stand rejected under 35 U.S.C. §101, as being directed to non-statutory subject matter.

Claims **38** and **39** stand rejected under 35 U.S.C. §112, first paragraph as being non-enabled by the specification.

Claims **1, 2, 10-13, 20, 21, 23, 30, 31 and 35–43** stand rejected under 35 U.S.C. §102(b) as being anticipated by Carson et. al, *College Accounting, Eighth Edition*, South Western Publishing Company, 1967, page 331 (hereinafter “Carson”).

Claims **3-9, 14-19, 22, 24-29 and 32-34** stand rejected under 35 U.S.C. §103(a) as being unpatentable over Carson.

Claims **1-19 and 40-42** are being appealed.

## STATUS OF AMENDMENTS

No amendments were filed subsequent to the Final Office Action mailed on June 30, 2006 (the “Final Action” herein). Appellants herein appeal the rejections of claims **1-19 and 40-42** recited in the Final Action based on 35 U.S.C. §102(b), 35 U.S.C. §103(a), and 35 U.S.C. §101.

## SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of the independent claims being appealed are provided below that include sufficient information about the claimed subject matter so that an informed review of the Examiner's adverse determination of patentability can be made.

As required by 37 C.F.R. § 41.37(c)(1)(v), reference is made to the Specification and Drawings, as appropriate. Any such reference:

- (i) is by way of example of the claimed subject matter only;
- (ii) is to be considered as potentially useful in clarifying the particular subject matter of the particular independent claim being explained (and not other claims or "the invention" as a whole), unless explicitly stated otherwise; and
- (iii) is not to be considered as broadening or narrowing the scope of any recited term from its meaning to one of ordinary skill in the art, unless explicitly stated otherwise.

Of the claims being appealed, claims **1 and 40-42** are the only independent claims.



## 1. Independent Claim 1

In accordance with one or more embodiments, a billing statement of the present invention comprises *a description of a transaction*. See, for example, the specification, page 4, lines 25–28, page 7, lines 5–10; page 8, lines 4-11; and Fig. 1 (for example, reference numbers 15, 20 and 25).

The billing statement further includes *an offer pointer associated with the transaction, wherein the offer pointer comprises information for use to review an offer*. See, for example, specification, page 4, lines 28 – 30; page 8, lines 16-30; page 11, lines 4-6 and 12-22 and Fig. 1 (for example, reference number 30).

## 2. Independent Claim 40

In accordance with one or more embodiments, a method according to the present invention comprises *receiving transaction information*. See, for example, the specification, page 6, line 8; and page 18, lines 10-14.

The method further includes *determining an offer pointer based on the transaction information, the offer pointer including information for use to review an offer*. See, for example, page 6, lines 8-10; and page 19, lines 8–11.

Lastly, the method includes *transmitting the offer pointer to a customer via a billing statement*. See, for example, page 6, lines 10-11.

### 3. Independent Claim 41

In accordance with one or more embodiments, a method according to the present invention comprises *receiving transaction information*. See, for example, the specification, page 6, lines 18-19; and page 18, lines 10-14.

The method further includes *determining an offer based on the transaction information*. See, for example, the specification, page 6, line 19; and page 19, lines 21-22.

The method also includes *determining an offer pointer, the offer pointer including information for use to review an offer*. See, for example, page 6, lines 19-21; and page 19, lines 23-24.

Lastly, the method includes *transmitting the offer pointer to a customer via a billing statement*. See, for example, page 6, lines 21-22; page 19, lines 25-26; page 47, lines 9-20; and Fig. 17 (for example, block S1708).

### 4. Independent Claim 42

In accordance with one or more embodiments, a method according to the present invention comprises *receiving from a customer an offer pointer associated with a transaction on a billing statement*. See, for example, the specification, page 47, lines 21-22; and Fig. 17 (for example, block S1710).

The method further includes *transmitting an offer to the customer, the offer being associated with the offer pointer*. See, for example, page 21, lines 7-8; page 48, lines 6-12; and Fig. 17 (for example, block S1714).

## **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Claims **1, 2, 10-13 and 40-42** stand rejected under 35 U.S.C. §102(b) as being anticipated by Carson et. al, *College Accounting, Eighth Edition*, South Western Publishing Company, 1967, page 331 (hereinafter “Carson”).

Claims **3-9 and 14-19** stand rejected under 35 U.S.C. §103(a) as being unpatentable over Carson.

Claims **1 – 19** stand rejected under 35 U.S.C. §101, as being directed to non-statutory subject matter.

## ARGUMENT

### 1. Form of Appeal Brief Argument

In the arguments herein, limitations of the claims are indicated in *italics*, claim numbers are indicated in **bold**, and the reference of record is indicated by underlining.

In separate arguments of patentability for separate claims (or groups of claims), Appellants have, where possible, referred to prior arguments to avoid undue repetition.

In the arguments below, Appellants refer to the Final Action, which is the Final Office Action containing the rejections appealed herein, and which was mailed on June 30, 2006 as part of Paper No. / Mail Date 20060614. Appellants also refer to the First Office Action, which is the first, non-final Office Action mailed on December 6, 2005 as part of Paper No. / Mail Date 20051201.

## **2. Advantages of the Claimed Invention**

In an embodiment, the claims being appealed are directed to a billing statement that includes at least one offer pointer associated with a transaction. The offer pointer advantageously facilitates the review of offers, and permits the presentation of more complicated and/or additional offers because offers are no longer limited by space constraints imposed by conventional billing statements. For example, a customer may utilize an offer pointer associated with a transaction on a credit card billing statement to access a website that contains information about a particular offer.

In some embodiments, the billing statement provides a description of one or more transactions and at least one offer pointer associated with a transaction, wherein a customer uses the offer pointer to access information concerning an offer or offers. For example, an offer pointer may be a Uniform Resource Locator (URL) for use to access information from a website that is associated particular offers, or the offer pointer may be a telephone number that the customer could use to call a representative to obtain information concerning one or more offers.

Other embodiments include methods for receiving transaction information, determining an offer pointer, and transmitting the offer pointer via a billing statement to a customer. In addition, methods are claimed that include receiving an offer pointer from a customer, or receiving a request from a customer to review an offer, and transmitting an offer to the customer. An embodiment also includes determining a new amount owed if the customer accepts the offer.

Billing statements that include an offer pointer permit offers to be generated that are tailored to the characteristics or needs of the customer, the seller, the creditor, or a third party. In addition, offer pointers may permit offers to be generated that reflect real-time conditions such as inventory or product demand. Thus, an offer pointer provided on a billing statement may increase the probability that a customer will review and ultimately accept an offer as compared to an offer presented using conventional methods. Customers may benefit in some embodiments because offers can be accepted to avoid previously incurred costs, and/ or to reduce outstanding balances.

Many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

### 3. Section 102(b) Rejection

Claims **1, 2, 10-13 and 40–42** stand rejected under 35 U.S.C. §102(b) as being anticipated by Carson et. al, *College Accounting, Eighth Edition*, South Western Publishing Company, 1967, page 331 (hereinafter “Carson”). Appellants traverse these rejections.

A reading of the Section 102(b) rejections reveals that the Examiner has consistently ignored and/or misinterpreted the limitations of the claims, and/or has incorrectly interpreted the teachings of the cited reference. At least one limitation of each independent claim is not disclosed or suggested by Carson. Accordingly, the Examiner has failed to show how any claim is anticipated by Carson.

The Examiner’s Section 102(b) rejections base on the above grounds are argued separately for the following groups of claims:

Claims **1, 2 and 11**

Claim **10**;

Claim **12**;

Claim **13**;

Claim **40**;

Claim **41**; and

Claim **42**.

Each group of claims is addressed below under a separate heading. The claims in different groups do not stand or fall together.

### **3.1. Applicable Law**

#### **3.1.1. *Prima Facie* burden**

The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2D 1443, 1444 (Fed. Cir. 1992).

#### **3.1.2. Substantial evidence required for all factual findings**

The Board is not permitted to accept conclusory, unsupported findings made by the Examiner that are not supported by substantial evidence made of record. All findings of fact by the U.S. Patent and Trademark Office must be supported by substantial evidence within the record. In re Gartside, 203 F.3d 1305, 1315, 53 U.S.P.Q.2D 1769, 1775 (Fed. Cir. 2000).

The Supreme Court has described “substantial evidence” in the following manner:

Substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. . . . Mere uncorroborated hearsay or rumor does not constitute substantial evidence.

Consolidated Edison Co. v. NLRB, 305 U.S. 197, 229, 83 L. Ed. 126, 59 S. Ct. 206 (1938); see also, Dickinson v. Zurko, 527 U.S. 150, 162, 50 U.S.P.Q.2D 1930, 1935, 144 L. Ed. 2d 143, 119 S. Ct. 1816 (1999) (“Zurko III”). “[R]eview under this standard involves an examination of the record



as a whole, taking into consideration evidence that both justifies and detracts from the agency's decision." Universal Camera Corp. v. NLRB, 340 U.S. 474, 487-88, 95 L. Ed. 456, 71 S. Ct. 456 (1951); Zurko III, 527 U.S. at 162.

### **3.1.3. Anticipation**

There must not be any differences between the claimed invention and the prior art disclosure, as viewed by a person of ordinary skill in the art, for anticipation to exist. Scripps Clinic & Res. Found. v. Genentech, Inc., 927 F.2d 1565, 18 U.S.P.Q.2D 1001 (Fed. Cir. 1991). Thus, the absence of any claim element from the reference negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 U.S.P.Q. 160 (Fed. Cir. 1986).

Anticipation requires identity of the claimed process and a process of the prior art; the claimed process, including each step thereof, must have been described or embodied, either expressly or inherently, in a single reference. Minnesota Min. & Mfg. Co., v. Johnson & Johnson Orthopedics, Inc., 976 F.2d 1559, 24 U.S.P.Q.2D 1321 (Fed. Cir. 1992); Glaverbel S.A. v. Northlake Mkt'g & Supp., Inc., 45 F.3d 1550, 33 U.S.P.Q.2D 1496 (Fed. Cir. 1995).

Further, as explained in Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1473, 43 U.S.P.Q.2D 1481, 1490 (Fed. Cir. 1997):

For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art. See In re Spada, 911 F.2d 705, 708, 15 U.S.P.Q.2D (BNA) 1655, 1657 (Fed. Cir. 1990) ("The [prior art] reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it." (citations omitted)). Although this disclosure requirement presupposes the knowledge of one skilled in the art

of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there.

**3.1.4. Claim interpretation must be consistent with the specification**

During examination, claims are given their broadest reasonable interpretation that those skilled in the art would reach, consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372, 54 U.S.P.Q.2D 1664, 1667 (Fed. Cir. 2000); In re Cortright, 165 F.3d 1353, 1359, 49 U.S.P.Q.2D 1464, 1468 (Fed. Cir. 1999). The “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” In re Morris, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2D 1023, 1027 (Fed. Cir. 1997).

### **3.2. Claims 1, 2 and 11**

Independent claim 1 pertains to a billing statement that includes:

*a description of a transaction; and  
an offer pointer associated with the transaction,  
wherein the offer pointer comprises information  
for use to review an offer.*

#### **3.2.1. The Carson reference fails to teach a billing statement that comprises an offer pointer associated with the transaction, wherein the offer pointer comprises information for use to review an offer**

Page 331 of Carson illustrates a “Statement of Consignment Sales” (see title at bottom of page), which is a monthly statement from “Mattoon Electric Co.” to “Windsor Hardware Co.”. The statement includes a balance forwarded from a previous statement (see line 1 amount of \$348.92), and a list of charges or credits (transactions) occurring on various dates in June (see list under line 2) that totals \$146.94. The total of \$146.94 is added to the balance forward amount of \$348.92 to arrive at the “total accountability” amount of \$495.86 appearing in line 3. A “working stock” amount of \$327.39 in line 4 is subtracted from the total accountability amount to arrive at the “List Sales” amount for the month of June of \$168.47 shown in line 5. In line 6, a 30% compensation amount of \$50.54 (equal to 30% of \$168.47) is subtracted from the list sales amount of \$168.47 to arrive at a net of \$117.93 in line 7. Two percent of this amount (\$2.36) shown in line 8,

which is categorized as “special compensation, if earned”, is subtracted from the net of \$117.93 to arrive at the net amount of \$115.57 in line 9. An explanation of the “special compensation” of line 8 appears at the bottom of the statement, which describes how an Agent “earns” the discount if payment is mailed by the seventh day of the month. In this example, the net amount in line 12 of \$115.57 is also the remittance due.

Appellants respectfully assert that the Examiner has not shown that Carson teaches *an offer pointer associated with the transaction, wherein the offer pointer comprises information for use to review an offer*. With respect to this claimed subject matter the Examiner asserts:

“... Carson contains many offer pointers such as “(see note below)”, “(-)”, and arrows to various values.” (Final Action, page 9, paragraph “b”).

Appellants respectfully assert that the cited markings that appear on the billing statement of Carson do not pertain to any of the transactions, rather they concern items that are to be adjusted by mathematical calculations beginning with the “total accountability” number appearing in line 3. In particular, the June transactions of Carson shown under line 2 include a transaction for June 7 referenced as “G1 7939” for the debit amount of \$37.20; a transaction for June 19 described as “G1 7579” for the debit amount of \$35.68; a transaction for June 21 described as “G1 7795” for the debit amount of \$28.24; a transaction for June 27 described as “G1 8311” for the debit amount of \$26.22; and a transaction for June 30 described as “G1 7691” for the debit amount of \$19.60. There are no markings associated with any of these transactions, much less an offer pointer. In fact, each of the indicia cited by the Examiner are associated with adjustments to be made to

the “total accountability” number (which includes such factors as “working stock” and “balance forward” that are unrelated to any transaction described in the statement) appearing in line 3. Thus, none of the indicia is *associated with a transaction*. Consequently, Appellants respectfully assert that the Examiner has ignored the feature of claim 1 which requires that the offer pointer *be associated with the transaction*, and that Carson fails to teach or suggest that feature.

Moreover, as noted above, the “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” (Emphasis added; In re Morris, 127 F.3d at 1054-55). The present specification defines an offer pointer as being, and claim 1 recites that it is, an item associated with a transaction of a billing statement that *comprises information for use to review an offer*. For example, an offer pointer may be a Uniform Resource Locator (URL) that can be used to reference a homepage of a website, or a telephone number that the consumer may call to obtain information about the offer (see specification, page 8, lines 17-21; page 9, lines 12-15; and page 11, lines 3-6). Furthermore, it is clear that an offer pointer differs from a statement offer in that the actual offer is not included in the billing statement (see specification, page 12, lines 19-21). Therefore, an offer pointer is an item used to access the offer, which Appellants respectfully submit is not taught or even suggested by Carson.

Furthermore, the dash in parenthesis “(-)” indicia cited by the Examiner that appear in the Carson statement indicates an amount that is

subtracted from the previous line. Thus, Appellants respectfully assert that these dash indicia do not *comprise information for use to review an offer*, and thus cannot be equated to the claimed offer pointer. Similarly, the cited “arrows” merely highlight a “net amount” in line 9 and a “remittance due” in line 12, and thus are not offer pointers *for use to review an offer* as required by claim 1. Yet further, the cited “(see note below)” of Carson concerns the “special compensation” number appearing in line 8, which is not a transaction, and therefore cannot teach or suggest *an offer pointer associated with the transaction*.

### 3.2.2. Conclusion

Appellants respectfully submit that Carson does not teach the particular combination of claimed subject matter of claim 1, and thus that the Section 102(b) rejection cannot stand. At best, the Examiner has made assertions about a known billing statement and adjustments made to sub-totals shown thereon, without any evidence or articulated reasoning concerning how such adjustments would have been recognized as being an *offer pointer associated with a transaction, wherein the offer pointer comprises information for use to review an offer*. Accordingly, the Examiner has not established that the specific billing statement of claim 1 was known in the prior art. Further, the Examiner has failed to indicate substantial evidence in support of the Examiner’s assertions as to what was known. Accordingly, the Examiner has failed to establish a *prima facie* case of anticipation for claim 1.

Furthermore, for at least the same reasons, no *prima facie* case of anticipation has been made for claims **2 and 11** which both depend upon

claim **1**. Accordingly, Appellants request reversal of the Section 102(b) rejection of claims **2 and 11**.

### **3.3. Claim 10**

Claim 10 stands rejected under Section 102(b) as being anticipated by Carson. Claim 10 depends from claim 1, and therefore all of the arguments provided above in Section 3.2. with respect to claim 1 are equally applicable to claim 10. Those arguments are incorporated by reference in this section.

Claim 10 provides the additional limitation of:

*wherein the offer pointer is not an offer.*

#### **3.3.1. Claim 1 is Patentable over Carson**

As explained above in Section 3.2, Carson does not anticipate independent claim 1. Accordingly, claim 10, which depends on claim 1 cannot be anticipated for at least the same reasons, which will not be repeated here for the sake of brevity. Accordingly, the obviousness rejection of claim 10 should be reversed.

#### **3.3.2. The Carson reference fails to teach a billing statement that comprises an offer pointer associated with the transaction, much less wherein the offer pointer is not an offer**

As explained above in Section 3.2.1., page 331 of Carson illustrates a static “Statement of Consignment Sales” sheet that includes a balance forwarded from a previous statement (line 1 amount of \$348.92), a list of charges or credits (transactions) occurring on various dates in June (the list under line 2), a “total accountability” amount of \$495.86 appearing in line 3,



and various adjustments made to the total accountability amount shown in lines 4-8 to arrive at a net amount of \$115.57 in line 9 (which is the same as the remittance due in line 12). As explained above, none of the transactions listed under line 2 of Carson includes an associated offer pointer. In particular, the Examiner admits that the dash markings (“(-)”) appearing on the billing statement of Carson reference subtraction functions performed on the various sub-totals beginning with the “total accountability” number. In addition, the cited “(see note below)” marking of Carson concerns the “special compensation” number appearing in line 8, which is not a transaction. Moreover, the cited “arrows” on the Carson statement merely highlight a “net amount” in line 9 and a “remittance due” in line 12, and each is not an *offer pointer comprising information for use to review an offer* recited in claim 1. Consequently, since Carson does not teach *an offer pointer associated with the transaction*, and does not teach an offer pointer that *comprises information for use to review an offer*, it cannot teach *wherein the offer pointer is not an offer*.

Furthermore, the “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” (Emphasis added; In re Morris, 127 F.3d at 1054-55). The present specification defines an offer pointer as an item associated with a billing statement that includes information that a consumer may use to review an offer. Examples of offer pointers include a Uniform Resource Locator (URL) that can be used to reference a homepage of a website, or a telephone

number that the consumer may call to obtain information about the offer (see specification, page 8, lines 17-21; page 9, lines 12-15; and page 11, lines 3-6). Furthermore, it is clear that an offer pointer differs from a statement offer in that the actual offer is not included in the billing statement (see specification, page 12, lines 19-21). Therefore, an offer pointer is an item used to access the offer, which Appellants respectfully submit is not taught or even suggested by Carson. In addition, an offer pointer is not an “offer”, which claim **10** makes clear by reciting that the offer pointer *is not an offer*. Accordingly, Appellants respectfully assert that Carson does not teach or suggest an offer pointer as claimed, and request reversal of the Section 102(b) rejection of claim **10**.

### **3.3.3. Conclusion**

The Appellants respectfully submit that Carson does not teach the claimed subject matter of claim **10**. Accordingly, the Section 102(b) rejection cannot stand. At best, the Examiner has made assertions about a known billing statement and adjustments made to sub-totals shown thereon, without any evidence or articulated reasoning concerning how such adjustments would have been recognized as being the same as *an offer pointer*, much less *wherein the offer pointer is not an offer*, as recited by claim **10**. Accordingly, the Examiner has not established that the specific feature recited by claim **10** was known in the prior art. Further, the Examiner has failed to indicate substantial evidence in support of the Examiner’s assertions as to what was known. Accordingly, the Examiner has failed to establish a *prima facie* case of anticipation for claim **10**, and thus Appellants request reversal of the Section 102(b) rejection.

### **3.4. Claim 12**

Claim 12 stands rejected under Section 102(b) as being anticipated by Carson. Claim 12 depends from claim 1, and therefore all of the arguments provided above in Section 3.2. with respect to claim 1 are equally applicable to claim 12. Those arguments are incorporated by reference in this section.

Claim 12 provides the additional limitation of:

*wherein a plurality of transactions are described in the billing statement, and wherein the offer pointer is associated with more than one of the plurality of transactions.*

#### **3.4.1. Claim 1 is Patentable over Carson**

As explained above in Section 3.2, Carson does not anticipate independent claim 1. Accordingly, claim 12, which depends on claim 1 cannot be anticipated for at least the same reasons, which will not be repeated here for the sake of brevity. Accordingly, the obviousness rejection of claim 12 should be reversed.

#### **3.4.2. The Carson reference fails to teach a billing statement that comprises an offer pointer associated with the transaction, much less wherein the offer pointer is associated with more than one of a plurality of transactions**

As explained above in Section 3.2.1., page 331 of Carson illustrates a static “Statement of Consignment Sales” sheet that includes a balance

forwarded from a previous statement (line 1 amount of \$348.92), a list of charges or credits (transactions) occurring on various dates in June (the list under line 2), a “total accountability” amount of \$495.86 appearing in line 3, and various adjustments made to the total accountability amount shown in lines 4-8 to arrive at a net amount of \$115.57 in line 9 (which is the same as the remittance due in line 12). As explained above, none of the transactions listed under line 2 of Carson includes an associated offer pointer. In particular, the Examiner admits that the dash markings (“(-)”) appearing on the billing statement of Carson reference subtraction functions performed on the various sub-totals beginning with the “total accountability” number. In addition, the cited “(see note below)” marking of Carson concerns the “special compensation” number appearing in line 8, which is not a transaction. Moreover, the cited “arrows” on the Carson statement merely highlight a “net amount” in line 9 and a “remittance due” in line 12, and each is not an *offer pointer comprising information for use to review an offer* recited in claim 1. Consequently, since Carson does not teach *an offer pointer associated with the transaction*, and does not teach an offer pointer that *comprises information for use to review an offer*, it cannot teach *wherein the offer pointer is associated with more than one of the plurality of transactions* as recited by claim 12.

Furthermore, the “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” (Emphasis added; In re Morris, 127 F.3d at 1054-55). The present

specification defines an offer pointer as an item associated with a billing statement that includes information that a consumer may use to review an offer. Examples of offer pointers include a Uniform Resource Locator (URL) that can be used to reference a homepage of a website, or a telephone number that the consumer may call to obtain information about the offer (see specification, page 8, lines 17-21; page 9, lines 12-15; and page 11, lines 3-6). Furthermore, it is clear that an offer pointer differs from a statement offer in that the actual offer is not included in the billing statement (see specification, page 12, lines 19-21). Therefore, an offer pointer is an item used to access the offer, which Appellants respectfully submit is not taught or even suggested by Carson. Moreover, Appellants respectfully assert that Carson does not teach or suggest an offer pointer that is *associated with more than one of the plurality of transactions*, and thus that claim **12** is not anticipated.

### **3.4.3. Conclusion**

The Appellants respectfully submit that Carson does not teach the claimed subject matter of claim **12**. Accordingly, the Section 102(b) rejection cannot stand. At best, the Examiner has made assertions about a known billing statement and adjustments made to sub-totals shown thereon, without any evidence or articulated reasoning concerning how such adjustments would have been recognized as being the same as *an offer pointer*, much less *wherein the offer pointer is associated with more than one of the plurality of transactions*, as recited by claim **12**. Accordingly, the Examiner has not established that the specific feature recited by claim **12** was known in the prior art. Further, the Examiner has failed to indicate

substantial evidence in support of the Examiner's assertions as to what was known. Accordingly, the Examiner has failed to establish a *prima facie* case of anticipation for claim **12**, and thus Appellants request reversal of the Section 102(b) rejection.

### **3.5. Claim 13**

Claim 13 stands rejected under Section 102(b) as being anticipated by Carson. Claim 13 depends from claim 1, and therefore all of the arguments provided above in Section 3.2. with respect to claim 1 are equally applicable to claim 13. These arguments are incorporated by reference in this section.

Claim 13 provides the additional limitation of:

*wherein the offer is and offer to reduce an amount owed associated with the transaction.*

#### **3.5.1 Claim 1 is Patentable over Carson**

As explained above in Section 3.2, Carson does not anticipate independent claim 1. Accordingly, claim 13, which depends on claim 1 cannot be anticipated for at least the same reasons, which will not be repeated here for the sake of brevity. Accordingly, the obviousness rejection of claim 13 should be reversed.

#### **3.5.2. The Carson reference fails to teach a billing statement that comprises an offer pointer associated with the transaction, much less wherein the offer is an offer to reduce an amount owed associated with the transaction**

As explained above in Section 3.2.1., page 331 of Carson illustrates a static “Statement of Consignment Sales” sheet that includes a balance forwarded from a previous statement (line 1 amount of \$348.92), a list of

charges or credits (transactions) occurring on various dates in June (the list under line 2), a “total accountability” amount of \$495.86 appearing in line 3, and various adjustments made to the total accountability amount shown in lines 4-8 to arrive at a net amount of \$115.57 in line 9 (which is the same as the remittance due in line 12). As explained above, none of the transactions listed under line 2 of Carson includes an associated offer pointer. In particular, the Examiner admits that the dash markings (“(-)”) appearing on the billing statement of Carson reference subtraction functions performed on the various sub-totals beginning with the “total accountability” number. In addition, the cited “(see note below)” marking of Carson concerns the “special compensation” number appearing in line 8, which is not a transaction. Moreover, the cited “arrows” on the Carson statement merely highlight a “net amount” in line 9 and a “remittance due” in line 12, and each is not an *offer pointer comprising information for use to review an offer* recited in claim 1. Consequently, since Carson does not teach *an offer pointer associated with the transaction*, and does not teach an offer pointer that *comprises information for use to review an offer*, it cannot teach *wherein the offer is an offer to reduce an amount owed associated with the transaction* as recited by claim 13.

Furthermore, the “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” (Emphasis added; In re Morris, 127 F.3d at 1054-55). The present specification defines an offer pointer as an item associated with a billing



statement that includes information that a consumer may use to review an offer. Examples of offer pointers include a Uniform Resource Locator (URL) that can be used to reference a homepage of a website, or a telephone number that the consumer may call to obtain information about the offer (see specification, page 8, lines 17-21; page 9, lines 12-15; and page 11, lines 3-6). Furthermore, it is clear that an offer pointer differs from a statement offer in that the actual offer is not included in the billing statement (see specification, page 12, lines 19-21). Therefore, an offer pointer is an item used to access the offer, which Appellants respectfully submit is not taught or even suggested by Carson. Moreover, Appellants respectfully assert that Carson does not teach an offer associated with an offer pointer that *is an offer to reduce an amount owed associated with the transaction*, and thus that claim 13 is not anticipated.

### **3.5.3. Conclusion**

The Appellants respectfully submit that Carson does not teach the claimed subject matter of claim 13. Accordingly, the Section 102(b) rejection cannot stand. At best, the Examiner has made assertions about a known billing statement and adjustments made to sub-totals shown thereon, without any evidence or articulated reasoning concerning how such adjustments would have been recognized as being the same as *an offer pointer*, much less *wherein the offer is an offer to reduce an amount owed associated with the transaction*, as recited by claim 13. Accordingly, the Examiner has not established that the specific feature recited by claim 13 was known in the prior art. Further, the Examiner has failed to indicate substantial evidence in support of the Examiner's assertions as to what was

known. Accordingly, the Examiner has failed to establish a *prima facie* case of anticipation for claim **13**, and thus Appellants request reversal of the Section 102(b) rejection.

### **3.6. Claim 40**

Independent claim **40** recites a method that includes:

*receiving transaction information;*  
*determining an offer pointer based on the transaction*  
*information, the offer pointer including information for use to*  
*review an offer; and*  
*transmitting the offer pointer to a customer via a billing*  
*statement.*

#### **3.6.1. The Carson reference does not teach or suggest a method that includes receiving transaction information and determining an offer pointer based on the transaction information, the offer pointer including information for use to review an offer as recited by claim 40**

As explained above in Section 3.2.1., page 331 of Carson illustrates a static “Statement of Consignment Sales” sheet that includes a balance forwarded from a previous statement (line 1 amount of \$348.92), a list of charges or credits (transactions) occurring on various dates in June (the list under line 2), a “total accountability” amount of \$495.86 appearing in line 3, and various adjustments made to the total accountability amount shown in lines 4-8 to arrive at a net amount of \$115.57 in line 9 (which is the same as the remittance due in line 12). Appellants respectfully assert Carson does not teach any process, and further that none of the transactions listed under line 2 includes an associated offer pointer.

Furthermore, the Examiner has not shown that Carson teaches or even suggests *receiving transaction information*, much less *determining an offer pointer based on the transaction information, the offer pointer including information for use to review an offer*. With respect to this claimed subject matter the Examiner asserts:

“Applicant argues that there is no offer pointer illustrated anywhere on the Carson statement. However, Carson contains many offer pointers such as “(see note below)”, “(-)”, and arrows to various values. Additionally, the applicant argues the Carson does not disclose “determining an offer pointer”... However, the Carson reference does disclose varying amounts upon which various calculations have been performed based upon offer pointers such as “(-)”. Since this points to a value that is subtracted from the previous value, the examiner is (sic.) believes this offer pointer is determining the step to take regarding the number in which it points, since this information is for use to review the following value.” (Final Action, pages 9-10, paragraph “b”).

As best understood, the Examiner apparently believes that the cited dash markings (“(-)”) that appear on the billing statement of Carson are somehow associated with transactions. However, the Examiner admits that the dash markings reference subtraction functions performed on the various sub-totals beginning with the “total accountability” number that appears in line 3. Thus, the dash markings are not associated with any of the transactions for the month of June listed under line 2, are not offer pointers, and do not include *information for use to review an offer*. These dash markings are instead associated with adjustments made to the “total accountability” number of line 3, and thus concern the billing statement as a whole, rather than being associated with any particular transaction.

Similarly, the cited “arrows” merely highlight a “net amount” in line 9 and a “remittance due” in line 12, and thus are not associated with any of the transactions, and are not the same as an *offer pointer including information for use to review an offer*. Consequently, Appellants respectfully assert that the Examiner has ignored and/or improperly interpreted the recitation of claim **40** of *determining an offer pointer based on the transaction information, the offer pointer for use to review an offer*, and that Carson fails to teach or suggest this feature.

Moreover, the “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” (Emphasis added; In re Morris, 127 F.3d at 1054-55). The present specification defines an offer pointer as an item associated with a billing statement that includes *information for use to review an offer*. For example, an offer pointer may be a Uniform Resource Locator (URL) that can be used to reference a homepage of a website, or a telephone number that the consumer may call to obtain information about the offer (see specification, page 8, lines 17-21; page 9, lines 12-15; and page 11, lines 3-6). Further, it is clear that the offer pointer differs from a statement offer in that the actual offer does not appear on the billing statement (see specification, page 12, lines 19-21). Thus, an offer pointer is an item used to access the offer, and Appellants respectfully submit that Carson fails to teach *determining an offer pointer... the offer pointer including information for use to review an offer* as recited by claim **40**.

**3.6.2. The Carson reference does not teach or suggest a method that includes transmitting the offer pointer to a customer via a billing statement**

Appellants respectfully submit that the Examiner has not shown that Carson teaches *transmitting the offer pointer to a customer via a billing statement*. With respect to this claimed subject matter the Examiner asserts:

“The applicant argues that Carson does not disclose an offer to reduce the amount owed associated with a transaction, and then transmitting an offer to the customer that is associated with the offer pointer. However, the “(see note)” offer pointer is an offer transmitted to the customer from the page in which the customer is offered a reduction in the amount owed” (Final Action, page 10, paragraph “c”).

As explained above, none of the cited markings that appear on the billing statement of Carson pertain to any of the transactions shown under line 2, instead they are related to amounts for use in adjusting other amounts by mathematical functions. Each of the cited indicia of Carson is associated with an adjustment to be made to the “total accountability” number of line 3, and thus these indicia concern the billing statement as a whole, instead of being associated with any of the transaction information. Consequently, Appellants respectfully assert that the Examiner has ignored and/or improperly interpreted the recitations of claim **40** of *determining an offer pointer based on the transaction information, and transmitting the offer pointer to a customer via a billing statement*.

Furthermore, the cited “(see note below)” marking of Carson concerns the “special compensation” number appearing in line 8, which is not a transaction. Thus, Carson fails to teach *determining an offer pointer based*

*on the transaction information.* Rather, this marking is a reminder for an Agent to pay the remittance due on time and obtain a two percent discount.

### **3.6.3. Conclusion**

The Appellants respectfully submit that Carson does not teach the particular combination of claimed subject matter of independent claim **40**. Accordingly, since Carson is the only cited reference relied upon to show that the claimed method of generating a billing statement was known to one of ordinary skill in the art, the Section 102(b) rejection cannot stand. At best, the Examiner has made assertions about a known billing statement and adjustments made to sub-totals shown thereon, without any evidence or articulated reasoning concerning how such adjustments would have been recognized as being the same as *receiving transaction information*, *determining an offer pointer based on the transaction information*, and *transmitting the offer pointer to a customer via a billing statement*, as recited by claim **40**. Accordingly, the Examiner has not established that the specific method recited by claim **40** was known in the prior art. Further, the Examiner has failed to indicate substantial evidence in support of the Examiner's assertions as to what was known. Accordingly, the Examiner has failed to establish a *prima facie* case of anticipation for independent claim **40**, and thus Appellants request reversal of these Section 102(b) rejections.

### **3.7. Claim 41**

Independent claim **41** recites a method that includes:

*receiving transaction information;*  
*determining an offer based on the transaction*  
*information;*  
*determining an offer pointer, the offer pointer including*  
*information for use to review the offer; and*  
*transmitting the offer pointer to a customer via a billing*  
*statement.*

#### **3.7.1. The Carson reference does not teach *receiving transaction information and determining an offer based on the transaction information*, and does not teach *determining an offer pointer, the offer pointer including information for use to review an offer*, as recited by claim 41**

As explained above in Section 3.2.1, page 331 of Carson illustrates a static “Statement of Consignment Sales” sheet that includes a balance forwarded from a previous statement (line 1 amount of \$348.92), a list of charges or credits (transactions) occurring on various dates in June (the list under line 2), a “total accountability” amount of \$495.86 appearing in line 3, and various adjustments made to the total accountability amount shown in lines 4-8 to arrive at a net amount of \$115.57 in line 9 (which is the same as the remittance due in line 12). Appellants respectfully assert Carson does



not teach any process, and further that none of the transactions listed under line 2 includes an associated offer pointer.

The Examiner has not shown that Carson teaches or even suggests *receiving transaction information*, much less *determining an offer based on the transaction information*. With respect to this claimed subject matter the Examiner asserts that Carson “discloses a method” that comprises these elements as recited by claim 41 without any explanation (see Final Action, page 4). This bald assertion is not substantial evidence, and thus the Examiner failed to make a *prima facie* case of anticipation for at least this reason.

Furthermore, the Examiner has not shown that Carson teaches *determining an offer pointer, the offer pointer including information for use to review an offer*. With respect to this claimed subject matter the Examiner asserts:

“Additionally, the applicant argues the Carson does not disclose “determining an offer pointer”... However, the Carson reference does disclose varying amounts upon which various calculations have been performed based upon offer pointers such as “(-)”. Since this points to a value that is subtracted from the previous value, the examiner is (sic.) believes this offer pointer is determining the step to take regarding the number in which it points, since this information is for use to review the following value.” (Final Action, pages 9-10, paragraph “b”).

As best understood, the Examiner apparently is asserting that the cited dash markings (“(-)”) that appear on the billing statement of Carson somehow include information includes information that a consumer may use to review an offer. But, as explained above in Section 3.6.1., the Examiner recognizes that the dash markings that appear in Carson merely indicate an

amount that is subtracted from the previous line. Thus, Appellants again respectfully assert that these dash indicia are not offer pointers, and furthermore that they do not *include information for use to review the offer* as recited by claim 41.

**3.7.2. The Carson reference does not teach transmitting the offer pointer to a customer via a billing statement as recited by claim 41**

Appellants respectfully submit that the Examiner has not shown that Carson teaches *transmitting the offer pointer to a customer via a billing statement*. With respect to this claimed subject matter the Examiner asserts:

“The applicant argues that Carson does not disclose an offer to reduce the amount owed associated with a transaction, and then transmitting an offer to the customer that is associated with the offer pointer. However, the “(see note)” offer pointer is an offer transmitted to the customer from the page in which the customer is offered a reduction in the amount owed” (Final Action, page 10, paragraph “c”).

But none of the cited markings that appear on the billing statement of Carson pertain to any of the transactions shown under line 2. Instead, these markings are related to amounts for use in adjusting other amounts by mathematical functions. In particular, each of the cited indicia is associated with an adjustment to be made to the “total accountability” number appearing in line 3, and thus these indicia concern the billing statement as a whole, instead of being associated with any of the transaction information. Consequently, Appellants respectfully assert that the Examiner has ignored

and/or improperly interpreted the recitation of claim **41** of *determining an offer based on the transaction information, and determining an offer pointer, the offer pointer including information for use to review the offer, and then transmitting the offer pointer to a customer via a billing statement.*

Furthermore, the cited “(see note below)” marking of Carson concerns the “special compensation” number appearing in line 8, which is not a transaction, and therefore cannot teach *determining an offer based on the transaction information*. Rather, this marking is a reminder for an Agent to pay the remittance due on time and obtain a two percent discount.

### **3.7.3. Conclusion**

The Appellants respectfully submit that Carson does not teach the particular combination of claimed subject matter of independent claim **41**. Accordingly, since Carson is the only cited reference relied upon to show that the claimed method of generating a billing statement was known to one of ordinary skill in the art, the Section 102(b) rejection cannot stand. At best, the Examiner has made assertions about a known billing statement and adjustments made to sub-totals shown thereon, without any evidence or articulated reasoning concerning how such adjustments would have been recognized as being the same as *receiving transaction information, determining an offer based on the transaction information, determining an offer pointer, the offer pointer including information for use to review the offer, and transmitting the offer pointer to a customer via a billing statement*, as recited by claim **41**. Accordingly, the Examiner has not established that the specific method recited by claim **41** was known in the prior art. Further, the Examiner has failed to indicate substantial evidence in support of the

Examiner's assertions as to what was known. Accordingly, the Examiner has failed to establish a *prima facie* case of anticipation for independent claim **41**, and thus Appellants request reversal of these Section 102(b) rejections.

### **3.8. Claim 42**

Independent claim **42** recites a method that includes:

*receiving from a customer an offer pointer associated with a transaction on a billing statement; and*  
*transmitting an offer to the customer, the offer being associated with the offer pointer.*

#### **3.8.1. The Carson reference fails to teach a method that includes receiving from a customer an offer pointer associated with a transaction on a billing statement, as recited by claim 42**

As explained above in Section 3.7.1, page 331 of Carson illustrates a static “Statement of Consignment Sales” sheet that includes a balance forwarded from a previous statement (line 1 amount of \$348.92), a list of charges or credits (transactions) occurring on various dates in June (the list under line 2), a “total accountability” amount of \$495.86 appearing in line 3, and various adjustments made to the total accountability amount shown in lines 4-8 to arrive at a net amount of \$115.57 in line 9 (which is the same as the remittance due in line 12). Appellants respectfully assert Carson does not teach any process, much less *receiving from a customer an offer pointer associated with a transaction on a billing statement*. Furthermore, Appellants again submit that Carson does not teach or even suggest an offer pointer as claimed.

Appellants respectfully assert that the Examiner has not shown that Carson teaches *receiving from a customer an offer pointer associated with a*

*transaction on a billing statement.* With respect to this claimed subject matter the Examiner asserts that, in Carson:

“... it is inherent, based upon the AGENT PLEASE NOTE: section that a copy of the statement, which contains offer pointers, is transmitted to the serving agent. Additionally, it is inherent that the next billing statement sent will determine a new amount owed by the customer that is associated with the various pointers, this is identified under the Balance column in Carson.” (Final Action, page 10, paragraph “d”).

Appellants respectfully submit that these conclusory statements do not constitute substantial evidence, as there is no support for stating that a “serving agent” receives the statement, especially since the “AGENT PLEASE NOTE” comment appearing at the bottom of Carson is merely a reminder to mail the remittance due by the seventh of the month. This comment is connected to the cited “(see note below)” marking of Carson, which concerns the “special compensation” number appearing in line 8. Accordingly, neither of these markings comprises *an offer pointer associated with a transaction*, which is what is received from a customer as recited by claim 42. Further, although it is true that “the next billing statement” will likely contain a “new amount owed”, no evidence has been provided to support the Examiner’s apparent assertion that this new amount constitutes *an offer to the customer, the offer being associated with the offer pointer* as required by claim 42.

**3.8.2. The Carson reference fails to teach a method that includes transmitting an offer to the customer, the offer being associated with the offer pointer as recited by claim 42**

Appellants respectfully submit that the Examiner has not shown that Carson teaches *transmitting an offer to the customer, the offer being associated with the offer pointer*. With respect to this claimed subject matter the Examiner asserts:

“The applicant argues that Carson does not disclose an offer to reduce the amount owed associated with a transaction, and then transmitting an offer to the customer that is associated with the offer pointer. However, the “(see note)” offer pointer is an offer transmitted to the customer from the page in which the customer is offered a reduction in the amount owed” (Emphasis added, see Final Action, page 10, paragraph “c”).

But, as explained above, none of the cited markings that appear on the billing statement of Carson pertain to any of the transactions shown under line 2. Rather, the cited markings pertain to amounts for use in adjusting other amounts by mathematical functions. In particular, each of the cited indicia is associated with an adjustment to be made to the “total accountability” number appearing in line 3, and thus these indicia concern the billing statement as a whole, instead of being associated with any of the transaction information. Consequently, Appellants assert that the Examiner has ignored the limitation of claim **42** that requires receiving an offer pointer *associated with a transaction on a billing statement*, and then *transmitting an offer* that is *associated with the offer pointer*.

Furthermore, the cited “(see note below)” marking of Carson concerns the “special compensation” number appearing in line 8, which is not a transaction, and therefore cannot teach *receiving... an offer pointer associated with a transaction... and transmitting an offer... associated with the offer pointer* as recited by claim **42**. Appellants contend that this marking is merely a reminder for an Agent to pay the remittance due on time.

### **3.8.3 Conclusion**

The Appellants respectfully submit that Carson does not teach the particular combination of claimed subject matter of independent claim **42**. Accordingly, since Carson is the only cited reference relied upon to show that the claimed method of claim **42** was known to one of ordinary skill in the art, the Section 102(b) rejection cannot stand. At best, the Examiner has made assertions about a known billing statement that includes markings connected to adjustments made to sub-totals shown thereon, without substantial evidence concerning how the statement of Carson would have been recognized as teaching *receiving from a customer an offer pointer associated with a transaction on a billing statement, and transmitting an offer to the customer, the offer being associated with the offer pointer*, as recited by claim **42**. Accordingly, the Examiner has not established that this method was known in the prior art. Further, the Examiner has failed to indicate substantial evidence in support of the Examiner’s assertions as to what was known. Accordingly, the Examiner has failed to establish a *prima facie* case of anticipation for independent claim **42**, and thus Appellants request reversal of these Section 102(b) rejections.



#### **4. Section 103(a) Rejections**

Claims **3-9, 14-19, 22, 24-29 and 32-34** stand rejected under 35 U.S.C. §103(a) as being unpatentable over Carson. Applicants traverse these rejections.

The Examiner's Section 103(a) rejections based on Carson are argued separately for each grouping of claims rejected under Section 103(a). In particular, the claims have been grouped as follows:

Claim **3**;  
Claim **4**;  
Claim **5**;  
Claim **6**;  
Claim **7**;  
Claim **8**;  
Claim **9**;  
Claims **14-16**;  
Claim **17**;  
Claim **18**; and  
Claim **19**.

The claims in different groups do not stand or fall together. Each group of claims is addressed below under a separate heading.

#### **4.1. Applicable Law**

##### **4.1.1. The Proper Legal Standard under 35 U.S.C. § 103(a)**

The Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. In re Fritch, 23 U.S.P.Q.2D 1780, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under Section 103, an examiner must show an un rebutted prima facie case of obviousness. In re Rouffet, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998). If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The factual predicates underlying an obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art. In re Rouffet. The secondary considerations are also essential components of the obviousness determination. In re Rouffet.

Finally, during examination, claims are given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 54 U.S.P.Q.2D 1664, 211 F.3d 1367 (Fed. Cir. 2000). The “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” In re Morris, 44 U.S.P.Q.2D 1023, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997).

#### **4.1.2. Substantial Evidence is Required of All Factual Findings**

In a determination of obviousness, factual findings as to scope and content of the prior art, level of ordinary skill in the art, differences between the claimed invention and the prior art, and secondary considerations of nonobviousness must be supported by substantial evidence. Novamedix Distrib. Ltd. v. Dickinson, 175 F. Supp. 2d 8, 9 (D.D.C. 2001).

"[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" In re Zurko, 59 U.S.P.Q.2D 1693, 258 F.3d 1379, 1385 (Fed. Cir. 2001); In re Lee, 61 U.S.P.Q.2D 1430, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Moreover, where a conclusion of obviousness rests on the prior knowledge in the field of the invention, then that "[p]rior knowledge in the field of the invention must be supported by tangible teachings of reference materials." Cardiac Pacemakers, Inc. v St. Jude Medical, Inc., 381 F.3d 1371 (Fed. Cir. 2004).

#### **4.1.3. Absent Substantial Evidence, No Prima Facie Case Exists**

To reject claims in an application under Section 103, an examiner must show an unrebutted *prima facie* case of obviousness. In re Rouffet, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

The initial burden of presenting a *prima facie* case of obviousness is upon the examiner. In re Oetiker, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. In re Rijckaert, 28

U.S.P.Q.2D 1955, 9 F.3d 1531, 1532 (Fed. Cir. 1993); Novamedix Distrib. Ltd. v. Dickinson, 175 F. Supp. 2d 8, 9 (D.D.C. 2001).

If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

**4.2. Claim 3**

Dependent claim **3** stands rejected under Section 103(a) as being unpatentable over Carson. Claim **3** depends from claim **1**, and therefore all of the arguments provided with respect to claim **1** above are equally applicable to claim **3**. Those arguments are incorporated by reference in this section.

Claim **3** provides the additional limitation of:

*wherein the billing statement comprises viewable electronic data.*

The Examiner has not established by substantial evidence of record that the additional claimed subject matter was known to one of ordinary skill in the art, or that a motivation, suggestion, or teaching to provide for such subject matter was known. Furthermore, the Examiner has not defined the level of ordinary skill in the art, and has not clearly indicated any evidence to support such a finding, which findings are necessary to assess obviousness. (M.P.E.P. §2141.03).

**4.2.1. Claim 1 is Patentable over Carson**

As explained above in Section 3.2, independent claim **1** is patentably distinct over Carson. Accordingly, claim **3**, which depends on claim **1** is allowable for at least the same reasons, which will not be repeated here for the sake of brevity. Accordingly, the obviousness rejection of claim **3** should be reversed.

#### **4.2.2. Examiner's Factual Findings**

Carson is the only reference cited by the Examiner to reject claim 3 for allegedly being obvious. However, the Examiner admits that:

“While it is not explicitly disclosed that the billing statement could also comprise viewable electronic data (i.e. electronic document), Official Notice is taken that it is old and well known to present billing and other financial information as viewable electronic data (i.e., computer displays). (Final Action, page 5, paragraph 6).

Appellants traversed the Examiner's “Official Notice” finding in the response mailed on April 6, 2006. In response, instead of supplying a reference to support the above quoted statement, the Examiner asserted:

“... since no structure supporting an electronic device has been claimed, the examiner has interpreted this language to mean “data, that is viewable, and has been created on an electronic device”. It is obvious that the Carson statement has been typed and not hand written. The only issue preventing the Carson statement from being inherent is that it would be possible to type the statement on a manual typewriter. However, it would have been obvious to one of ordinary skill in the art at the time the statement was created to use an electronic typewriter or computer.” (Final Action, page 11, paragraph “e”).

#### **4.2.3. Examiner's Findings Are Not Supported by Substantial Evidence of Record**

Appellants respectfully submit that there is no evidence to support the Examiner's assertions quoted above. In particular, Carson does not teach or suggest that any of the information illustrated in the “Statement of Consignment Sales”, published as page 331 of an Accounting textbook, could be in the form of *viewable electronic data*. Furthermore, the wording of claim 3 requires that the billing statement be electronically displayed so

that, for example, a consumer can select a hyperlink to access a website that presents offers for review by the consumer (see application, page 5, lines 1-3). Therefore, the Examiner's convenient assertions, even if true, do not teach or suggest the subject matter of these claims.

Furthermore, Appellants submit that the above quoted language, without more, is not substantial evidence that is required to be made of record in order to support an obviousness rejection. Accordingly, because the record does not support this obviousness rejection, no *prima facie* case has been made. Thus, the Section 103(a) rejection should be reversed.

#### **4.2.4. The Examiner Has Failed to Determine the Level of Ordinary Skill in the Art**

Moreover, the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

#### **4.2.5. Conclusion**

For the reasons set forth above, the Section 103(a) rejection of claim 3 cannot stand. The Examiner has not established a *prima facie* case of obviousness because there has been no showing that the limitation of this claim (together with those of the independent claim 1 upon which it relies) are taught by any reference of record. Furthermore, the Examiner has failed to provide substantial evidence to support any of the Examiner's assertions

as to what was known in the art at the time the application was filed, and thus those assertions cannot support an obviousness rejection. Yet further, the level of ordinary skill in the pertinent art was not resolved, and thus the Examiner could not have been able to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention. Accordingly, Appellants respectfully request reversal of the Section 103(a) rejection of claim 3.



### **4.3. Claim 4**

Dependent claim 4 stands rejected under Section 103(a) as being unpatentable over Carson. Claim 4 depends from claim 1, and therefore all of the arguments provided with respect to claim 1 above are equally applicable to claim 4. Those arguments are incorporated by reference in this section.

Claim 4 provides the additional limitation of:

*wherein the offer pointer comprises a Uniform Resources Locator*

The Examiner has not established by substantial evidence of record that the additional claimed subject matter was known to one of ordinary skill in the art, or that a motivation, suggestion, or teaching to provide for such subject matter was known. Furthermore, the Examiner has not defined the level of ordinary skill in the art, and has not clearly indicated any evidence to support such a finding, which findings are necessary to assess obviousness. (M.P.E.P. §2141.03).

#### **4.3.1. Claim 1 is Patentable over Carson**

As explained above in Section 3.2, independent claim 1 is patentably distinct over Carson. Accordingly, claim 4, which depends on claim 1 is allowable for at least the same reasons which will not be repeated here for the sake of brevity. Accordingly, the rejection of claim 4 should be reversed.

#### **4.3.2. The Examiner's Factual Findings**

Carson is the only reference cited by the Examiner to reject claim 4 for allegedly being obvious. However, the Examiner admits that:

“Carson... does not explicitly disclose that the offer pointer is a URL, a telephone number, or a code associated with either of these. However it would have been obvious to one having ordinary skill in the art... that the offer pointer (which directs the customer to the offer) would comprise of appropriate instructions based on the method by which the customer is to receive the offer... One would have been motivated to update the 1960's billing statement of Carson to include more modern communication means, such as a telephone number or URL, in order to take advantage of the latest communication means available at the time of invention.” (Final Action, pages 6-7, paragraph 6).

#### **4.3.3. Examiner's Findings Are Not Supported by Substantial Evidence of Record**

Appellants respectfully submit that there is no evidence to support the assertion that one skilled in the art “would have been motivated to update the 1960's billing statement of Carson to include more modern communication means” as suggested by the Examiner. Moreover, as explained above with regard to independent claim 1, Carson does not teach or even suggest an offer pointer as claimed, much less that the offer pointer comprises a *Uniform Resources Locator* as recited by claim 4. Therefore, the Examiner's convenient assertions, quoted above, do not rise to the level of substantial evidence, which is required to be made of record in order to support an obviousness rejection. Accordingly, since no support exists in the record for this obviousness rejection, no *prima facie* case has been made and the Section 103(a) rejection should be reversed.

#### **4.3.4. The Examiner Has Failed to Determine the Level of Ordinary Skill in the Art**

Moreover, the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

#### **4.3.5. Conclusion**

For the reasons set forth above, the Section 103(a) rejection of claim 4 cannot stand. The Examiner has not established a *prima facie* case of obviousness because there has been no showing that the limitation of this claim (together with independent claim 1) are taught by any reference of record. Furthermore, the Examiner has failed to provide substantial evidence to support any of the Examiner’s assertions as to what was known in the art at the time the application was filed, and thus those assertions cannot support an obviousness rejection. Yet further, the level of ordinary skill in the pertinent art was not resolved, and thus the Examiner could not have been able to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention. Accordingly, Appellants respectfully request reversal of the Section 103(a) rejection of claim 4.

#### **4.4. Claim 5**

Dependent claim **5** stands rejected under Section 103(a) as being unpatentable over Carson. Claim **5** depends from claim **4**, which in turn depends from claim **1**, and therefore all of the arguments provided with respect to claims **1 and 4** above are equally applicable to claim **5**. Those arguments are incorporated by reference in this section.

Claim **5** provides the additional limitation of:

*wherein the offer pointer (of claim 4) further comprises a code for submission to a website referenced by the Uniform Resources Locator*

The Examiner has not established by substantial evidence of record that the additional claimed subject matter was known to one of ordinary skill in the art, or that a motivation, suggestion, or teaching to provide for such subject matter was known. Furthermore, the Examiner has not defined the level of ordinary skill in the art, and has not clearly indicated any evidence to support such a finding, which findings are necessary to assess obviousness. (M.P.E.P. §2141.03).

##### **4.4.1. Claim 1 is Patentable over Carson**

As explained above in Section 3.2, independent claim **1** is patentably distinct over Carson. Accordingly, claim **5**, which indirectly depends on claim **1** is allowable for at least the same reasons which will not be repeated here for the sake of brevity. Accordingly, the rejection of claim **5** should be reversed.

#### **4.4.2. The Examiner's Factual Findings**

Carson is the only reference cited by the Examiner to reject claim 5 for allegedly being obvious. However, the Examiner admits that:

“Carson... does not explicitly disclose that the offer pointer is a URL, a telephone number, or a code associated with either of these. However it would have been obvious to one having ordinary skill in the art... that the offer pointer (which directs the customer to the offer) would comprise of appropriate instructions based on the method by which the customer is to receive the offer... One would have been motivated to update the 1960's billing statement of Carson to include more modern communication means, such as a telephone number or URL, in order to take advantage of the latest communication means available at the time of invention.” (Final Action, pages 6-7, paragraph 6).

#### **4.4.3. Examiner's Findings Are Not Supported by Substantial Evidence of Record**

Appellants respectfully submit that there is no evidence to support the assertion that one skilled in the art “would have been motivated to update the 1960's billing statement of Carson to include more modern communication means” as suggested by the Examiner. Moreover, as explained above with regard to independent claim 1, Carson does not teach or even suggest an offer pointer as claimed, much less that the offer pointer is a Uniform Resource Locator and further comprises *a code for submission to a website referenced by the Uniform Resources Locator* as claimed by claim 5. Therefore, the Examiner's convenient assertions, quoted above, do not rise to the level of substantial evidence, which is required to be made of record in order to support an obviousness rejection. Accordingly, since no support

exists in the record for this obviousness rejection, no *prima facie* case has been made and the Section 103(a) rejection should be reversed.

**4.4.4. The Examiner Has Failed to Determine the Level of Ordinary Skill in the Art**

Moreover, the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

**4.4.5. Conclusion**

For the reasons set forth above, the Section 103(a) rejection of claim 5 cannot stand. The Examiner has not established a *prima facie* case of obviousness because there has been no showing that the limitation of this claim (together with independent claim 1) are taught by any reference of record. Furthermore, the Examiner has failed to provide substantial evidence to support any of the Examiner’s assertions as to what was known in the art at the time the application was filed, and thus those assertions cannot support an obviousness rejection. Yet further, the level of ordinary skill in the pertinent art was not resolved, and thus the Examiner could not have been able to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention. Accordingly, Appellants respectfully request reversal of the Section 103(a) rejection of claim 5.

#### **4.5. Claim 6**

Dependent claim **6** stands rejected under Section 103(a) as being unpatentable over Carson. Claim **6** depends from claim **5**, which in turn depends on claim **4**, which depends on claim **1**, and therefore all of the arguments provided with respect to claims **1, 4 and 5** above are equally applicable to claim **6**. Those arguments are incorporated by reference in this section.

Claim **6** provides the additional limitation of:

*wherein the code (of claim **5**) is associated with the offer*

The Examiner has not established by substantial evidence of record that the additional claimed subject matter was known to one of ordinary skill in the art, or that a motivation, suggestion, or teaching to provide for such subject matter was known. Furthermore, the Examiner has not defined the level of ordinary skill in the art, and has not clearly indicated any evidence to support such a finding, which findings are necessary to assess obviousness. (M.P.E.P. §2141.03).

##### **4.5.1. Claim 1 is Patentable over Carson**

As explained above in Section 3.2, independent claim **1** is patentably distinct over Carson. Accordingly, claim **6**, which indirectly depends on claim **1**, is allowable for at least the same reasons which will not be repeated here for the sake of brevity. Accordingly, the rejection of claim **6** should be reversed.

#### **4.5.2. The Examiner's Factual Findings**

Carson is the only reference cited by the Examiner to reject claim 5 for allegedly being obvious. However, the Examiner admits that:

“Carson... does not explicitly disclose that the offer pointer is a URL, a telephone number, or a code associated with either of these. However it would have been obvious to one having ordinary skill in the art... that the offer pointer (which directs the customer to the offer) would comprise of appropriate instructions based on the method by which the customer is to receive the offer... One would have been motivated to update the 1960's billing statement of Carson to include more modern communication means, such as a telephone number or URL, in order to take advantage of the latest communication means available at the time of invention.” (Final Action, pages 6-7, paragraph 6).

#### **4.5.3. Examiner's Findings Are Not Supported by Substantial Evidence of Record**

Appellants respectfully submit that there is no evidence to support the assertion that one skilled in the art “would have been motivated to update the 1960's billing statement of Carson to include more modern communication means” as suggested by the Examiner. Moreover, as explained above with regard to independent claim 1, Carson does not teach or even suggest an offer pointer as claimed, much less that the offer pointer is a Uniform Resource Locator (claim 4), includes a code for submission to a website referenced by the Uniform Resources Locator (claim 5), or *wherein the code is associated with the offer* as recited by claim 6. Therefore, the Examiner's convenient assertions, quoted above, do not rise to the level of substantial evidence, which is required to be made of record in order to support an



obviousness rejection. Accordingly, since no support exists in the record for this obviousness rejection, no *prima facie* case has been made and the Section 103(a) rejection should be reversed.

**4.5.4. The Examiner Has Failed to Determine the Level of Ordinary Skill in the Art**

Moreover, the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

**4.5.5. Conclusion**

For the reasons set forth above, the Section 103(a) rejection of claim 6 cannot stand. The Examiner has not established a *prima facie* case of obviousness because there has been no showing that the limitation of this claim (together with independent claim 1) are taught by any reference of record. Furthermore, the Examiner has failed to provide substantial evidence to support any of the Examiner’s assertions as to what was known in the art at the time the application was filed, and thus those assertions cannot support an obviousness rejection. Yet further, the level of ordinary skill in the pertinent art was not resolved, and thus the Examiner could not have been able to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention. Accordingly,

Appellants respectfully request reversal of the Section 103(a) rejection of claim 6.

**4.6. Claim 7**

Dependent claim 7 stands rejected under Section 103(a) as being unpatentable over Carson. Claim 7 depends from claim 1, and therefore all of the arguments provided with respect to claim 1 are equally applicable to claim 7. These arguments are incorporated by reference in this section.

Claim 7 provides the additional limitation of:

*wherein the offer pointer comprises a telephone number.*

The Examiner has not established by substantial evidence of record that the additional claimed subject matter was known to one of ordinary skill in the art, or that a motivation, suggestion, or teaching to provide for such subject matter was known. Furthermore, the Examiner has not defined the level of ordinary skill in the art, and has not clearly indicated any evidence to support such a finding, which findings are necessary to assess obviousness. (M.P.E.P. §2141.03).

**4.6.1. Claim 1 is Patentable over Carson**

As explained above in Section 3.2, independent claim 1 is patentably distinct over Carson. Accordingly, claim 7, which depends on claim 1 is allowable for at least the same reasons, which will not be repeated here for the sake of brevity. Accordingly, the obviousness rejection of claim 7 should be reversed.

#### **4.6.2. The Examiner's Factual Findings**

Carson is the only reference cited by the Examiner to reject claim 7 for allegedly being obvious. However, the Examiner admits that:

“Carson... does not explicitly disclose that the offer pointer is a URL, a telephone number, or a code associated with either of these. However it would have been obvious to one having ordinary skill in the art... that the offer pointer (which directs the customer to the offer) would comprise of appropriate instructions based on the method by which the customer is to receive the offer... One would have been motivated to update the 1960's billing statement of Carson to include more modern communication means, such as a telephone number or URL, in order to take advantage of the latest communication means available at the time of invention.” (Final Action, pages 6-7, paragraph 6).

#### **4.6.3. Examiner's Findings Are Not Supported by Substantial Evidence of Record**

Appellants respectfully submit that there is no evidence to support the assertion that one skilled in the art “would have been motivated to update the 1960's billing statement of Carson to include more modern communication means” as suggested by the Examiner. Moreover, as explained above with regard to independent claim 1, Carson does not teach or even suggest an offer pointer as claimed, much less that the offer pointer is *a telephone number* as claimed by claim 7. Therefore, the Examiner's convenient assertions, quoted above, do not rise to the level of substantial evidence, which is required to be made of record in order to support an obviousness rejection. Accordingly, since no support exists in the record for this obviousness rejection, no *prima facie* case has been made and the Section 103(a) rejection should be reversed.

#### **4.6.4. The Examiner Has Failed to Determine the Level of Ordinary Skill in the Art**

Moreover, the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

#### **4.6.5. Conclusion**

For the reasons set forth above, the Section 103(a) rejection of claim 7 cannot stand. The Examiner has not established a *prima facie* case of obviousness because there has been no showing that the limitation of this claim (together with independent claim 1) are taught by any reference of record. Furthermore, the Examiner has failed to provide substantial evidence to support any of the Examiner’s assertions as to what was known in the art at the time the application was filed, and thus those assertions cannot support an obviousness rejection. Yet further, the level of ordinary skill in the pertinent art was not resolved, and thus the Examiner could not have been able to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention. Accordingly, Appellants respectfully request reversal of the Section 103(a) rejection of claim 7.

#### **4.7. Claim 8**

Dependent claim **8** stands rejected under Section 103(a) as being unpatentable over Carson. Claim **8** depends from claim **7**, which in turn depends from claim **1**, and therefore all of the arguments provided with respect to claims **1 and 7** above are equally applicable to claim **8**. Those arguments are incorporated by reference in this section.

Claim **8** provides the additional limitation of:

*wherein the offer pointer (of claim 7) further comprises a code.*

The Examiner has not established by substantial evidence of record that the additional claimed subject matter was known to one of ordinary skill in the art, or that a motivation, suggestion, or teaching to provide for such subject matter was known. Furthermore, the Examiner has not defined the level of ordinary skill in the art, and has not clearly indicated any evidence to support such a finding, which findings are necessary to assess obviousness. (M.P.E.P. §2141.03).

##### **4.7.1. Claim 1 is Patentable over Carson**

As explained above in Section 3.2, independent claim **1** is patentably distinct over Carson. Accordingly, claim **8**, which indirectly depends on claim **1** is allowable for at least the same reasons which will not be repeated here for the sake of brevity. Accordingly, the rejection of claim **8** should be reversed.

#### **4.7.2. The Examiner's Factual Findings**

Carson is the only reference cited by the Examiner to reject claim 8 for allegedly being obvious. However, the Examiner admits that:

“Carson... does not explicitly disclose that the offer pointer is a URL, a telephone number, or a code associated with either of these. However it would have been obvious to one having ordinary skill in the art... that the offer pointer (which directs the customer to the offer) would comprise of appropriate instructions based on the method by which the customer is to receive the offer... One would have been motivated to update the 1960's billing statement of Carson to include more modern communication means, such as a telephone number or URL, in order to take advantage of the latest communication means available at the time of invention.” (Final Action, pages 6-7, paragraph 6).

#### **4.7.3. Examiner's Findings Are Not Supported by Substantial Evidence of Record**

Appellants respectfully submit that there is no evidence to support the assertion that one skilled in the art “would have been motivated to update the 1960's billing statement of Carson to include more modern communication means” as suggested by the Examiner. Moreover, as explained above with regard to independent claim 1, Carson does not teach or even suggest an offer pointer as claimed, much less that the offer pointer is a telephone number and further comprises *a code* as claimed by claim 8. Therefore, the Examiner's convenient assertions, quoted above, do not rise to the level of substantial evidence, which is required to be made of record in order to support an obviousness rejection. Accordingly, since no support exists in the record for this obviousness rejection, no *prima facie* case has been made and the Section 103(a) rejection should be reversed.

#### **4.7.4. The Examiner Has Failed to Determine the Level of Ordinary Skill in the Art**

Moreover, the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

#### **4.7.5. Conclusion**

For the reasons set forth above, the Section 103(a) rejection of claim 8 cannot stand. The Examiner has not established a *prima facie* case of obviousness because there has been no showing that the limitation of this claim (together with independent claim 1) are taught by any reference of record. Furthermore, the Examiner has failed to provide substantial evidence to support any of the Examiner’s assertions as to what was known in the art at the time the application was filed, and thus those assertions cannot support an obviousness rejection. Yet further, the level of ordinary skill in the pertinent art was not resolved, and thus the Examiner could not have been able to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention. Accordingly, Appellants respectfully request reversal of the Section 103(a) rejection of claim 8.



**4.8. Claim 9**

Dependent claim 9 stands rejected under Section 103(a) as being unpatentable over Carson. Claim 9 depends from claim 8, which in turn depends on claim 1, and therefore all of the arguments provided with respect to claims 1 and 8 above are equally applicable to claim 9. Those arguments are incorporated by reference in this section.

Claim 9 provides the additional limitation of:

*wherein the code (of claim 8) is associated with the offer*

The Examiner has not established by substantial evidence of record that the additional claimed subject matter was known to one of ordinary skill in the art, or that a motivation, suggestion, or teaching to provide for such subject matter was known. Furthermore, the Examiner has not defined the level of ordinary skill in the art, and has not clearly indicated any evidence to support such a finding, which findings are necessary to assess obviousness. (M.P.E.P. §2141.03).

**4.8.1. Claim 1 is Patentable over Carson**

As explained above in Section 3.2, independent claim 1 is patentably distinct over Carson. Accordingly, claim 9, which indirectly depends on claim 1, is allowable for at least the same reasons which will not be repeated here for the sake of brevity. Accordingly, the rejection of claim 9 should be reversed.

#### **4.8.2. The Examiner's Factual Findings**

Carson is the only reference cited by the Examiner to reject claim 9 for allegedly being obvious. However, the Examiner admits that:

“Carson... does not explicitly disclose that the offer pointer is a URL, a telephone number, or a code associated with either of these. However it would have been obvious to one having ordinary skill in the art... that the offer pointer (which directs the customer to the offer) would comprise of appropriate instructions based on the method by which the customer is to receive the offer... One would have been motivated to update the 1960's billing statement of Carson to include more modern communication means, such as a telephone number or URL, in order to take advantage of the latest communication means available at the time of invention.” (Final Action, pages 6-7, paragraph 6).

#### **4.8.3. Examiner's Findings Are Not Supported by Substantial Evidence of Record**

Appellants respectfully submit that there is no evidence to support the assertion that one skilled in the art “would have been motivated to update the 1960's billing statement of Carson to include more modern communication means” as suggested by the Examiner. Moreover, as explained above with regard to independent claim 1, Carson does not teach or even suggest an offer pointer as claimed, much less that the offer pointer is a telephone number (claim 7), further comprises a code (claim 8), or *wherein the code is associated with the offer* as recited by claim 9. Therefore, the Examiner's convenient assertions, quoted above, do not rise to the level of substantial evidence, which is required to be made of record in order to support an obviousness rejection. Accordingly, since no support exists in the record for

this obviousness rejection, no *prima facie* case has been made and the Section 103(a) rejection should be reversed.

#### **4.8.4. The Examiner Has Failed to Determine the Level of Ordinary Skill in the Art**

Moreover, the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

#### **4.8.5. Conclusion**

For the reasons set forth above, the Section 103(a) rejection of claim 9 cannot stand. The Examiner has not established a *prima facie* case of obviousness because there has been no showing that the limitation of this claim (together with independent claim 1) are taught by any reference of record. Furthermore, the Examiner has failed to provide substantial evidence to support any of the Examiner’s assertions as to what was known in the art at the time the application was filed, and thus those assertions cannot support an obviousness rejection. Yet further, the level of ordinary skill in the pertinent art was not resolved, and thus the Examiner could not have been able to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention. Accordingly, Appellants respectfully request reversal of the Section 103(a) rejection of claim 9.

#### **4.9. Claims 14-16**

Dependent claims **14-16** stand rejected under Section 103(a) as being unpatentable over Carson. Claims **14-16** each depend from claim **1**. Thus, all of the arguments provided above with respect to claim **1** are equally applicable to claims **14-16**. Those arguments are incorporated by reference in this section.

Claims **14-16**, which depend on claim **1**, provide the additional limitations of:

*wherein the offer is an offer to reduce an interest rate on an amount owed.* (claim **14**);

*wherein the offer is an offer to extend a due date by which a minimum due amount is due.* (claim **15**); and

*wherein the offer is an offer to eliminate a minimum due amount.* (claim **16**).

The Examiner has not established by substantial evidence of record that the additional claimed subject matter was known to one of ordinary skill in the art, or that a motivation, suggestion, or teaching to provide for such subject matter was known. Furthermore, the Examiner has not defined the level of ordinary skill in the art, and has not clearly indicated any evidence to support such a finding, which findings are necessary to assess obviousness. (M.P.E.P. §2141.03).

**4.9.1 Claim 1 is Patentable over Carson**

As explained above in Section 5.2, independent claim 1 is patentably distinct over Carson. Accordingly, claims 14-16, which each depend on claim 1, are allowable for at least the same reasons which will not be repeated here for the sake of brevity. Accordingly, the rejection of claims 14-16 should be reversed.

**4.9.2. The Examiner's Factual Findings**

Carson is the only reference cited by the Examiner to reject claims 14-16 for allegedly being obvious. However, the Examiner admits that:

“While it is not explicitly disclosed that the terms of the offer is to reduce the interest rate, to extend the due date, or to eliminate the minimum amount due, these are all well know types of offer terms used by billers to entice customers to remit payments early, to use a particular form or remittance,(electronic vs. check), etc. Therefore it would have been obvious... to set the terms of the offer so as to eliminate the minimum amount due, extend the due date, or change the interest rate. One would have been motivated to set different terms for different offers in order to give the biller more latitude in selecting offers to present.” (Final Action, page 7, paragraph 6).

**4.9.3. Examiner's Findings Are Not Supported by Substantial Evidence of Record**

Appellants respectfully submit that there is no evidence to support the Examiner's assertion, quoted above, that one skilled in the art “would have been motivated to set different terms for different offers in order to give the biller more latitude in selecting offers to present”. Moreover, as explained above with regard to independent claim 1, Carson does not teach or suggest

an offer pointer as claimed. Therefore, the Examiner's convenient assertions are not substantial evidence, which is required to be made of record in order to support an obviousness rejection. Accordingly, since no support exists in the record for this obviousness rejection, no *prima facie* case has been made and the Section 103(a) rejection should be reversed.

#### **4.9.4. The Examiner Has Failed to Determine the Level of Ordinary Skill in the Art**

Moreover, the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

#### **4.9.5. Conclusion**

For the reasons set forth above, the Section 103(a) rejections of claims **14-16** cannot stand. The Examiner has not established a *prima facie* case of obviousness because there has been no showing that the limitations of these claims (together with those of the independent claims upon which they rely) are taught by any reference of record. Furthermore, the Examiner has failed to provide substantial evidence to support any of the Examiner's assertions as to what was known in the art at the time the application was filed, and thus those assertions cannot support an obviousness rejection. Yet further, the level of ordinary skill in the pertinent art was not resolved, and thus the Examiner could not have been able to determine what “would have been

obvious to one of ordinary skill in the art” at the time of the invention.

Accordingly, Appellants respectfully request reversal of the Section 103(a) rejections of claims **14-16**.

#### **4.10. Claim 17**

Dependent claim 17 stands rejected under Section 103(a) as being unpatentable over Carson. Claim 17 depends from independent claim 1, and thus the arguments provided above with respect to claim 1 are equally applicable to claims 17. Those arguments are incorporated by reference in this section.

Claim 17 depends on claim 1, and provides the additional limitations of:

*a second description of a second transaction; and  
a second offer pointer associated with the second transaction,  
wherein the second offer pointer includes second information for use  
to review a second offer.*

The Examiner has not established by substantial evidence of record that the additional claimed subject matter was known to one of ordinary skill in the art, or that a motivation, suggestion, or teaching to provide for such subject matter was known. Furthermore, the Examiner has not defined the level of ordinary skill in the art, and has not clearly indicated any evidence to support such a finding, which findings are necessary to assess obviousness. (M.P.E.P. §2141.03).

##### **4.10.1 Claim 1 is Patentable over Carson**

As explained above in Sections 4.2, independent claim 1 is patentably distinct over Carson. Accordingly, claim 17, which depends on claim 1, is allowable for at least the same reasons which will not be repeated here for



the sake of brevity. Accordingly, the rejection of claim 17 should be reversed.

#### **4.10.2. The Examiner's Factual Findings**

Carson is the only reference cited by the Examiner to reject claim 17 for allegedly being obvious. However, the Examiner admits that:

“Carson... does not explicitly disclose a second offer pointer associated with the second transaction. However it would have been obvious to one having ordinary skill in the art... to provide the same or different terms for each of the transactions listed on Carson's billing statement. One would have been motivated to provide separate offers for separate transactions in order to allow the biller to “push” certain types of transactions. For example, a biller may give a straight 2% discount for all transactions paid within 7 days and may give an additional 2% discount for each transaction over \$100 to entice the purchaser to make higher value transactions.” (Final Action, pages 7-8, paragraph 6).

#### **4.10.3. Examiner's Findings Are Not Supported by Substantial Evidence of Record**

Appellants respectfully submit that there is no evidence to support the Examiner's assertions quoted above. Moreover, as explained above with regard to independent claim 1, Carson does not even teach or suggest *an offer pointer* as claimed. Accordingly, Carson cannot be said to teach or suggest *a second description of a second transaction and a second offer pointer* that includes *second information to review a second offer*.

The Examiner has conveniently fabricated a motivation for one skilled in the art to provide “separate offers for separate transactions in order to

allow the biller to “push” certain types of transactions”, and gives an example of: “a biller may give a straight 2% discount for all transactions paid within 7 days and may give an additional 2% discount for each transaction over \$100 to entice the purchaser to make higher value transactions.” But Carson does not suggest or teach any such offer regime, and Appellants thus respectfully assert that the Examiner’s bald assertions do not rise to the level of substantial evidence (which is required to be made of record in order to support an obviousness rejection). Accordingly, since no support exists in the record for this obviousness rejection, no *prima facie* case has been made and the Section 103(a) rejection should be reversed.

**4.10.3.      The Examiner Has Failed to Determine the Level of Ordinary Skill in the Art**

Moreover, the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

**4.10.4.      Conclusion**

For the reasons set forth above, the Section 103(a) rejection of claim 17 cannot stand. The Examiner has not established a *prima facie* case of obviousness because there has been no showing that the limitation of this claim (together with independent claim 1) are taught by any reference of record. Furthermore, the Examiner has failed to provide substantial

evidence to support any of the Examiner's assertions as to what was known in the art at the time the application was filed, and thus those assertions cannot support an obviousness rejection. Yet further, the level of ordinary skill in the pertinent art was not resolved, and thus the Examiner could not have been able to determine what "would have been obvious to one of ordinary skill in the art" at the time of the invention. Accordingly, Appellants respectfully request reversal of the Section 103(a) rejection of claim 17.

#### **4.11. Claim 18**

Dependent claim **18** stands rejected under Section 103(a) as being unpatentable over Carson. Claim **18** depends from claim **17**, which in turn depends from claim **1**, and therefore all of the arguments provided with respect to claims **1 and 17** above are equally applicable to claim **18**. Those arguments are incorporated by reference in this section.

Claim **18** provides the additional limitation of:

*wherein the second offer pointer (of claim 17) is identical to the first offer.*

The Examiner has not established by substantial evidence of record that the additional claimed subject matter was known to one of ordinary skill in the art, or that a motivation, suggestion, or teaching to provide for such subject matter was known. Furthermore, the Examiner has not defined the level of ordinary skill in the art, and has not clearly indicated any evidence to support such a finding, which findings are necessary to assess obviousness. (M.P.E.P. §2141.03).

##### **4.11.1. Claim 1 is Patentable over Carson**

As explained above in Section 3.2, independent claim **1** is patentably distinct over Carson. Accordingly, claim **18**, which indirectly depends on claim **1** is allowable for at least the same reasons which will not be repeated here for the sake of brevity. Accordingly, the rejection of claim **18** should be reversed.

**4.11.2.      The Examiner's Factual Findings**

Carson is the only reference cited by the Examiner to reject claim 18 for allegedly being obvious. However, the Examiner admits that:

“Carson... does not explicitly disclose a second offer pointer associated with the second transaction. However it would have been obvious to one having ordinary skill in the art... to provide the same or different terms for each of the transactions listed on Carson's billing statement. One would have been motivated to provide separate offers for separate transactions in order to allow the biller to “push” certain types of transactions. For example, a biller may give a straight 2% discount for all transactions paid within 7 days and may give an additional 2% discount for each transaction over \$100 to entice the purchaser to make higher value transactions.” (Final Action, pages 7-8, paragraph 6).

**4.11.3.      Examiner's Findings Are Not Supported by  
Substantial Evidence of Record**

Appellants respectfully submit that there is no evidence to support the Examiner's assertions quoted above. Moreover, as explained above with regard to independent claim 1, Carson does not even teach or suggest *an offer pointer* as claimed. Accordingly, Carson cannot be said to teach or suggest *a second description of a second transaction and a second offer pointer* that includes *second information to review a second offer* (claim 17), much less *wherein the second offer is identical to the first offer* as recited by claim 18.

The Examiner has conveniently fabricated a motivation for one skilled in the art to provide “separate offers for separate transactions in order to allow the biller to “push” certain types of transactions”, and gives an example of: “a biller may give a straight 2% discount for all transactions

paid within 7 days and may give an additional 2% discount for each transaction over \$100 to entice the purchaser to make higher value transactions.” Appellants submit that Carson does not suggest or teach any such offer regime, and thus respectfully assert that the Examiner’s bald assertions do not rise to the level of substantial evidence (which is required to be made of record in order to support an obviousness rejection). Accordingly, since no support exists in the record for this obviousness rejection, no *prima facie* case has been made and the Section 103(a) rejection should be reversed.

**4.11.3.      The Examiner Has Failed to Determine the Level of Ordinary Skill in the Art**

Moreover, the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

**4.11.4.      Conclusion**

For the reasons set forth above, the Section 103(a) rejection of claim 18 cannot stand. The Examiner has not established a *prima facie* case of obviousness because there has been no showing that the limitation of this claim (together with independent claim 1) are taught by any reference of record. Furthermore, the Examiner has failed to provide substantial evidence to support any of the Examiner’s assertions as to what was known

in the art at the time the application was filed, and thus those assertions cannot support an obviousness rejection. Yet further, the level of ordinary skill in the pertinent art was not resolved, and thus the Examiner could not have been able to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention. Accordingly, Appellants respectfully request reversal of the Section 103(a) rejection of claim **18**.

**4.12. Claim 19**

Claim **19** depends on claim **1**, and thus all of the arguments provided with respect to claim **1** are equally applicable to claim **19**. Those arguments are incorporated by reference in this section.

Claim **19** provides the additional limitation of:

*wherein the offer pointer is located adjacent to the description.*

The Examiner has not established by substantial evidence of record that the additional claimed subject matter was known to one of ordinary skill in the art, or that a motivation, suggestion, or teaching to provide for such subject matter was known. Furthermore, the Examiner has not defined the level of ordinary skill in the art, and has not clearly indicated any evidence to support such a finding, which findings are necessary to assess obviousness. (M.P.E.P. §2141.03).

**4.12.1. Claim 1 is Patentable over Carson**

As explained above in Section 3.2, independent claim **1** is patentably distinct over Carson. Accordingly, claim **19**, which depends on claim **1**, is allowable for at least the same reasons which will not be repeated here for the sake of brevity. Accordingly, the rejection of claim **19** should be reversed.



**4.12.2. Examiner's Factual Findings**

The Examiner admits that Carson does not disclose the claimed subject matter, but then makes a conclusory statement, as follows:

“Carson... does not disclose that the offer is located adjacent to the transaction description. However, it is a design choice of the biller on where to place the various information and data on the billing statement page. It would have been obvious... to place the offer adjacent to the transaction information to which the offer pertains. One would have been motivated to place it adjacent in order to allow the customer to quickly identify which offer pertained to which transaction (if the offers were not all the same).” (Final Action, page 8, paragraph 7)

**4.12.3. Examiner's Findings are Not Supported by Substantial Evidence of Record**

The record cannot support the Examiner's rejection of claim **19** as being obvious in light of Carson. As discussed above with regard to claim **1**, which arguments are incorporated herein for the sake of brevity, the Examiner ignored or unreasonably interpreted the claim limitations concerning *an offer pointer associated with a transaction*. Accordingly, Appellants submit that Carson cannot be said to teach or suggest the embodiment *wherein the offer pointer is located adjacent to the description* recited by claim **19**.

Thus, for at least the same reasons discussed above with respect to claim **1**, the Examiner has failed to establish a *prima facie* case of obviousness of dependent claim **19**. In particular, Carson does not suggest or teach the billing statement recited by claim **1**, and thus claim **19** should be allowable for at least the same reasons. Furthermore, the Examiner's

assertions do not rise to the level of substantial evidence, which must be made of record in order to support an obviousness rejection. Accordingly, since no support exists in the record for this obviousness rejection, no *prima facie* case has been made and the Section 103(a) rejection should be reversed.

**4.12.4.      The Examiner Has Failed to Determine the Level of Ordinary Skill in the Art**

Moreover, the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

**4.12.5.      Conclusion**

For the reasons set forth above, Appellants submit that the Section 103(a) rejection of claim **19** cannot stand. The Examiner has failed to indicate substantial evidence in support of the Examiner’s assertions as to what was known (including the asserted motivation), and those assertions, even if true, could not support an obviousness rejection. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Thus, the Appellants request reversal of the section 103(a) rejection of claim **19**.

## 5. Section 101 Rejection

Claims 1-19 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. (Final Action, page 2)

### **5.1 Section 101— The Proper Legal Test for Statutory Subject Matter**

35 U.S.C. §101 provides:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

In choosing expansive terms such as “manufacture” and “composition of matter”, modified by the comprehensive term “any”, Congress plainly intended that the patent laws would be given wide scope. “The use of the expansive term ‘any’ in §101 represents Congress’s intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in §101 and the other parts of Title 35.” In re Alappat, 33 F.3d 1526 (Fed. Cir. 1994) (*en banc*). The Supreme Court has also construed §101 broadly, noting that Congress intended statutory subject matter to “include anything under the sun made by man.” Diamond v. Chakrabarty, 447 U.S. 303, 309, 100 S. Ct. 2204 (1980).

The proper legal test for the presence of statutory subject matter is only that a claimed process or apparatus produce a “useful, concrete and tangible result”. See, e.g., State St. Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 1375, 47 USPQ2d 1596, 1602 (Fed. Cir. 1998),

cert. denied, 525 U.S. 1093, 142 L. Ed. 2d 704, 119 S. Ct. 851 (1999) (“For purpose of our analysis, as noted above, claim 1 is directed to a machine programmed with the Hub and Spoke software and admittedly produces a ‘useful, concrete, and tangible result.’ ... This renders it statutory subject matter, even if the useful result is expressed in numbers, such as price, profit, percentage, cost, or loss.”)

While other criteria, if satisfied, may be useful in indicating the presence of a "useful, concrete and tangible result" (and therefore indicate that a claim is statutory), the absence of such criteria does not preclude a finding of statutory subject matter. Such other criteria are not requirements, but merely some of several ways that can demonstrate that an invention produces a useful, concrete and tangible result. For example, the recitation of physical limitations may be helpful, but is not necessary to render a claim statutory. AT & T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 1359, 50 U.S.P.Q.2D 1447 (Fed. Cir. 1999) (“Whatever may be left of the earlier test, if anything, this type of physical limitations analysis seems of little value....”). Even where a claim incorporates a mathematical algorithm, in contrast to focusing on a physical limitations inquiry, the inquiry deemed the “ultimate issue” “focuses on whether the mathematical algorithm is applied in a practical manner to produce a useful result.” AT & T Corp., 172 F.3d at 1359-60.

In discussing this proper legal test, the Court of Appeals for the Federal Circuit acknowledged the judicially-created exceptions to statutory subject matter. See, e.g., AT & T Corp., 172 F.3d at 1355 (“[The Supreme Court] has specifically identified three categories of unpatentable subject matter: ‘laws of nature, natural phenomena, and abstract ideas.’” (quoting

Diamond v. Diehr, 450 U.S. at 185)); State St. Bank, 149 F.3d at 1373. The Court also clarified that “certain types of mathematical subject matter, standing alone, represent nothing more than abstract ideas until reduced to some type of practical application, i.e., ‘a useful, concrete and tangible result.’” State Street Bank, 149 F.3d at 1373.

Under the proper standard, claims have been found statutory because they produced useful results such as "a final share price", State Street Bank, 149 F.3d at 1373; a "value of a PIC indicator" which represents "information about the call recipient's PIC", AT&T Corp., 172 F.3d at 1357; and a condition of a patient's heart, Arrhythmia Research Tech. Inc. v. Corazonix Corp., 958 F.2d 1053, 1060, 22 U.S.P.Q.2D 1033, 1039 (Fed. Cir. 1992). Clearly, a claimed invention that satisfies this proper standard for statutory subject matter (e.g., by producing a useful, concrete and tangible result) cannot, by definition, also fall within the judicially-created exception of abstract ideas.

The threshold for utility is not high – an invention is “useful” under §101 if it is capable of providing some identifiable benefit.

## **5.2 Claims 1, 2 and 4-19**

Claim 1 is independent. Claims 2 and 4-19 each directly or indirectly depends from claim 1. Accordingly, the arguments provided with respect to claim 1 are equally applicable to claims 2 and 4-19.

As the rejection under Section 101 applies a standard that departs from the requisite legal analysis, the rejection is flawed. In particular, to properly reject a claim under 35 U.S.C. §101, the Examiner must:

(A) make a *prima facie* showing that the claimed invention lacks utility, and

(B) provide a sufficient evidentiary basis for factual assumptions relied upon in establishing the *prima facie* showing.

In re Gaubert, 524 F.2d 1222, 1224, 187 USPQ 664, 666 (CCPA 1975) ("Accordingly, the PTO must do more than merely question operability - it must set forth factual reasons which would lead one skilled in the art to question the objective truth of the statement of operability."). (See also, MPEP 2107.02(IV)).

Appellants respectfully assert that the Examiner has failed to establish a *prima facie* case that claims 1, 2 and 4-19 are not eligible subject matter because no factual findings or evidentiary basis for the assumptions relied upon to reach a conclusion that claims 1, 2 and 4-19 are non-statutory has been provided. Appellants also respectfully assert, for the reasons set forth below, that claims 1, 2 and 4-19 produce useful, concrete and tangible results. Moreover, Appellants submit that none of claims 1, 2 and 4-19 fit into one of the excluded categories of 35 U.S.C. § 101.

### **5.2.1 The Basis for Rejection**

Based on the Examiner's statements in the First Office Action and the Final Action (which incorporates the rejections of the First Office Action), Appellants understand that the rejection of pending claims **1, 2 and 4-19** for being directed to non-statutory subject matter is based on the following alleged findings:

“...The claims are directed to non-functional descriptive material, i.e. a printed document. Per MPEP2106B1: Descriptive material can be characterized as either functional descriptive material or nonfunctional descriptive material. In this context, functional descriptive material consists of data structures and computer programs which impart functionality when employed as a computer component. Nonfunctional descriptive material includes but is not limited to music, literary works, and a compilation of mere arrangement of data. Both types of descriptive material are nonstatutory when claimed as descriptive material *per se*. *In re Warmerdan*, 33. F.3d 1360, 31 USPQ2d, at 1759. The claimed billing statement is merely a document containing information, presumably about a monetary amount owed by the receiving party. Therefore, none of the claims include any functional language describing actions to be taken to nor procedures to be followed in order to produce the invention, and are thus considered to be nonfunctional descriptive material.” (First Office Action, paragraph 4, pages 2-3.)

The Examiner also asserts:

“The applicant argues that the invention is directed to a new and novel article of manufacture. However, the examiner is unable to determine from the metes and bounds of the claim that the invention fits into any statutory class. The claim as currently written could be a verbal statement to a customer that they are purchasing an item and indicting how much they owe, and pointing to a price indicated on the register. Alternatively, as stated in the previous office action the claim may be direct to

printed matter on a document. The applicant admits that it is intended to be an article of manufacture (Amendment, Page 11, lines 1-3) and states that no printed matter is being claimed (Amendment, Page 12, line 17) and that the difference between the invention and the prior art lie in the limitation of the claims other than any printed matter (Amendment, Page 12, lines 17-19). Additionally the applicant further admits that the claims are not method claims that the claims are not necessarily computer-related (Amendment, Page 13, lines 4-5). Given the arguments and admissions from the applicant the examiner is unable to verify the applicants claim that the invention is an article of manufacture. The examiner can not fathom an article of manufacture containing a description of a transaction that is not printed matter and not related to a computer that contains an offer pointer. Even the example of a verbal statement requires a computer display and/or printed matter.” (Final Action, page 9, paragraph ‘a’)

**5.2.2. The Examiner has failed to establish by substantial evidence that the claimed subject matter is non-statutory descriptive material**

The Examiner inappropriately characterizes the pending claims as being directed to “non-functional descriptive material, i.e. a printed document” (First Office Action, paragraph 4, pages 2-3; Final Action, page 9, section ‘a’). In fact, claim 1 recites a billing statement that includes:

*a description of a transaction; and  
an offer pointer associated with the transaction,  
wherein the offer pointer comprises information  
for use to review an offer.*



The billing statement may be a printed document, such as a credit card billing statement, and in some embodiments, may comprise an electronically displayed billing statement. Therefore, the offer pointer could be, for example, a toll-free telephone number printed adjacent a description of a transaction on a credit card billing statement, or a hyperlink positioned adjacent to a total amount owed on an electronically displayed billing statement. In some embodiments, the offer pointer may be customized based on details of the transaction (See Specification, page 4, line 28 to page 5, line 6). Appellants thus respectfully submit that claim 1 provides for a new and unobvious functional relationship between a description of a transaction of a billing statement and an offer pointer associated with the transaction, and as explained below, that this functional relationship distinguishes the present claims from the cited prior art.

Appellants respectfully submit that the Examiner's reliance on In re Warmerdam, 33 F.3d 1360, 31 U.S.P.Q. 2d. 1759 (Fed. Cir. 1994) is misplaced. In Warmerdam, claims 1-4 and 6 were rejected for lack of statutory subject matter under §101, which claims recited methods for generating a "data structure" representing the shape of a physical object in a position and/or motion control machine as a hierarchy of bubbles. In re Warmerdam, 33 F.3d at 1355. In upholding the decision of the Patent and Trademark Office Board of Appeals that the Appellant's method claims 1-4 and claim 6 were unpatentable, the Court considered computer-related cases for guidance (Id. at 1359) and stated:

"The body of claim 1 recites... steps [that] describe nothing more than the manipulation of basic mathematical constructs, the paradigmatic "abstract idea". As the Supreme Court has made clear, "an idea of itself is not patentable" (citations omitted); taking

several abstract ideas and manipulating them together adds nothing to the basic equation.” Id. at 1360.

Thus, the holding in Warmerdam is an application of the principal that laws of nature, natural phenomena, and abstract ideas are not within the categories of inventions that may be patented under Section 101. But Appellants respectfully submit that the Court’s reasoning in that case is not applicable here, as pending claims **1, 2 and 4-19** do not recite a “law of nature”, and are not directed to an “abstract idea”. Furthermore, claims **1, 2 and 4-19** are not method claims that describe nothing more than “manipulation of basic mathematical constructs”. Rather, claim **1** recites a billing statement that includes the novel feature of *an offer pointer associated with the transaction, wherein the offer pointer comprises information for use to review an offer*. Accordingly, Appellants submit that In re Warmerdam is inapplicable.

Furthermore, the billing statement recited by claim **1** is novel and advantageous because a consumer may use the offer pointer to access complex details of offers that are provided elsewhere, and thus such offers do not have to take up any space on the billing statement. In addition, the offer pointer permits tailoring of offers to the consumer (Specification, page 5, lines 7-14). Accordingly, Appellants respectfully assert that such a billing statement includes functional material, and therefore is not “merely a document containing information, presumably about a monetary amount owed” as argued by the Examiner.

The Examiner also asserts that: “The claim as currently written could be a verbal statement to a customer that they are purchasing an item and indicating how much they owe, and pointing to a price indicated on the

register”. There simply is no support for such a statement. Claim 1 pertains to “a billing statement”, and the present application discloses that the billing statement may be a printed document, such as a credit card billing statement, or in some embodiments, may comprise an electronically displayed billing statement (see Application, page 4, lines 25 to page 5, line 6, and Fig. 1).

**5.2.3. Claims 1, 2 and 4-19 provide useful, concrete and tangible results**

Appellants respectfully assert that claims 1, 2 and 4-19 provide a useful, concrete and tangible result. Appellants note that the Federal Circuit in State St. Bank found a useful, concrete, and tangible result in the mere determining of “a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades,” even though the claim 1 at issue there, for example, did not recite any of those potential uses of any “final share price,” nor did it require any “output” of the price to any “regulatory authorities”. The Federal Circuit recognized that claim 1 is a “machine,” but clarified that this is only a threshold issue: a claim must be directed to one of the four categories of subject matter contemplated under Section 101. The Court continued:

“The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to n9 --process, machine, manufacture, or composition of matter--but rather on the essential characteristics of the subject matter, in particular, its practical utility. ...For purpose of our analysis, as noted above, claim 1 is directed to a machine programmed with the Hub and Spoke software and admittedly produces a "useful, concrete, and tangible result." Alappat, 33 F.3d at 1544, 31 U.S.P.Q.2D

(BNA) at 1557. This renders it statutory subject matter...”.  
State Street Bank, 149 F.3d at 1375.

Pending claim 1 recites a billing statement that may be an article of manufacture (for example, a printed credit card billing statement) or a composition of matter (for example, an electronically displayed billing statement). Moreover, the inclusion of an offer pointer that may be used by a customer to review an offer is a useful, concrete, and tangible result. Accordingly, since the proper standard for statutory subject matter under Section 101 requires only that a claim meet one of the four categories of subject matter and produce a useful, concrete, and tangible result, claim 1 is directed to statutory subject matter. Accordingly, since the Examiner’s rejection under Section 101 applies a standard that departs from the requisite legal analysis, Appellants assert that the rejection is flawed.

**5.2.4. The Examiner has failed to establish that claims 1, 2 and 4-19 fit into any category of unpatentable subject matter**

Appellants submit that claims 1, 2 and 4-19 do not fit into any of the three categories identified by the courts that comprise unpatentable subject matter. In particular, independent claim 1 does not seek to protect a law of nature, or natural phenomena, or an abstract idea. Thus, claims 1, 2 and 4-19 are directed to patentable subject matter.

**5.2.5. Dependent claims 2 and 4-19 recite patentable subject matter**

Appellants respectfully submit that the Examiner has ignored the various limitations of the dependent claims, which must be addressed separately for compliance with Section 101. In particular, the dependent claims recite that the billing statement comprises a printed document (claim **2**), that the offer pointer is a Uniform Resources Locator (claim **4**), wherein the URL includes a code for submission to a website (claim **5**), and wherein the code is associated with the offer (claim **6**). Furthermore, some dependent claims require that the offer pointer comprise a telephone number, and include a code, and wherein the code is associated with the offer (claims **7-9**). In addition, other dependent claims recite that a plurality of transactions are described on the billing statement, and the offer pointer is associated with more than one of the transactions (claim **12**), and that the offer is an offer to reduce an amount owed associated with the transaction, or to reduce an interest rate on an amount owed, or to extend a due date by which a minimum amount is due, or to eliminate a minimum due amount (claims **13-16**). Furthermore, other dependent claims add a second description of a second transaction, and a second offer pointer associated with the second transaction, wherein the second offer pointer includes second information for us to review a second offer (claim **17**), and wherein the second offer may be identical to the first offer (claim **18**). Lastly, a dependent claim adds that the offer pointer is located adjacent to the description (claim **19**). Appellants respectfully assert that such dependent aspects provide for a useful, concrete and tangible result.

**5.2.6. Conclusion**

In view of the above remarks, Appellants submit that the Examiner has failed to establish a *prima facie* case to reject claims **1-19** for lack of statutory subject matter, and thus the rejection of claims **1-19** under 35 U.S.C. §101 cannot stand.

### **5.3. Claim 3**

Claim 3 stands rejected under Section 101. Appellants traverse.

Claim 3 depends from claim 1, and therefore all of the arguments provided with respect to claim 1 in Section 5.2. above are equally applicable to claim 3. Those arguments are incorporated by reference in this section.

Claim 3 provides the additional limitation of:

*wherein the billing statement comprises viewable electronic data.*

Appellants respectfully assert that the Examiner has failed to establish a *prima facie* case that claim 3 does not include eligible subject matter because no factual findings or evidentiary basis for the assumptions relied upon to reach a conclusion that claim 3 is non-statutory has been provided. Appellants also respectfully assert, for the reasons set forth below, that claim 3, in concert with claim 1, produces a useful, concrete and tangible result. Moreover, Appellants submit that neither of claims 1 and 3 fit into one of the excluded categories of 35 U.S.C. § 101.

#### **5.3.1 The Basis for Rejection**

As explained above in section 5.2.1., based on the Examiner's statements in the First Office Action and the Final Action (incorporating the rejections of the First Office Action), Appellants understand that claim 3 has been rejected for being directed to non-statutory subject matter as directed to: "non-functional descriptive material, i.e. a printed document". The text

of the full rejection from the Final Action is quoted above in Section 5.2.1., and thus is not included here for the sake of brevity.

**5.3.2. The Examiner has failed to establish by substantial evidence that the claimed subject matter is non-statutory descriptive material**

The Examiner inappropriately characterizes the pending claims as being directed to “non-functional descriptive material, i.e. a printed document” (First Office Action, paragraph 4, pages 2-3; Final Action, page 9, section ‘a’). In fact, claim 1 recites a billing statement that includes:

*a description of a transaction; and  
an offer pointer associated with the transaction,  
wherein the offer pointer comprises information  
for use to review an offer.*

As made clear by claim 3, the billing statement includes *viewable electronic data*. Therefore, the offer pointer may be, for example, a hyperlink positioned adjacent to a total amount owed on an electronically displayed billing statement. Furthermore, the offer pointer may be customized based on details of the transaction (See Specification, page 4, line 28 to page 5, line 6). Appellants thus respectfully submit that claim 3 in concert with claim 1 provides for a new and unobvious functional relationship between the *viewable electronic data* of the billing statement and *an offer pointer associated with the transaction*, and as explained below,



that this functional relationship distinguishes the present claims from the cited prior art.

As Appellants explained in Section 5.2.2., Examiner's reliance on In re Warmerdam is misplaced. In particular, the holding in Warmerdam is an application of the principal that laws of nature, natural phenomena, and abstract ideas are not within the categories of inventions that may be patented under Section 101. But the Court's reasoning in that case is not applicable here, as pending claim 3 does not recite a "law of nature", and is not directed to an "abstract idea". Furthermore, claims **1 and 3** are not method claims that describe nothing more than "manipulation of basic mathematical constructs". Rather, claim 3 in concert with claim 1 recites a billing statement with *viewable electronic data* that includes the novel feature of *an offer pointer associated with the transaction, wherein the offer pointer comprises information for use to review an offer*.

Accordingly, Appellants submit that In re Warmerdam is inapplicable.

Furthermore, a billing statement including viewable electronic data is novel and advantageous because a consumer may use the offer pointer to access complex details of offers (for example, by clicking on a hyperlink) that are provided elsewhere (for example, on a web page), and thus such offers do not have to take up any space on the billing statement. In addition, the offer pointer permits tailoring of offers to the consumer (see specification, page 5, lines 7-14). Accordingly, Appellants respectfully assert that such a billing statement with viewable electronic data includes functional material, and therefore is not "merely a document containing information, presumably about a monetary amount owed" as asserted by the Examiner.

**5.3.3. Claim 3 provides a useful, concrete and tangible result**

Appellants respectfully assert that claim 3 provides a useful, concrete and tangible result. As noted above in Section 5.2.3., the Federal Circuit in State St. Bank found a useful, concrete, and tangible result in the mere determining of “a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades,” even though the claim 1 at issue there, for example, did not recite any of those potential uses of any “final share price,” nor did it require any “output” of the price to any “regulatory authorities”. The Federal Circuit recognized that claim 1 is a “machine,” but clarified that this is only a threshold issue: a claim must be directed to one of the four categories of subject matter contemplated under Section 101.

In the present case, claim 3, in combination with claim 1, recites a billing statement that is a composition of matter: an electronically viewable billing statement. Moreover, the inclusion of viewable electronic data facilitates the use of the offer pointer by a customer to review an offer, which is a useful, concrete, and tangible result. Accordingly, since the proper standard for statutory subject matter under §101 requires only that a claim meet one of the four categories of subject matter and produces a useful, concrete, and tangible result, claim 3 is directed to statutory subject matter. Since the Examiner’s rejection under Section 101 applies a standard that departs from the requisite legal analysis, Appellants assert that the rejection is flawed.

**5.3.4. The Examiner has failed to establish that claim 3 fits into any category of unpatentable subject matter**

Appellants submit that claim 3 does not fit into any of the three categories identified by the courts that comprise unpatentable subject matter. In particular, claim 3 does not seek to protect a law of nature, or natural phenomena, or an abstract idea. Thus, claim 3 is directed to patentable subject matter.

**5.3.5. Conclusion**

In view of the above remarks, Appellants submit that the Examiner has failed to establish a *prima facie* case to reject claim 3 for lack of statutory subject matter, and thus the rejection of claims 3 under 35 U.S.C. §101 cannot stand.

## CONCLUSION

Appellants submit that the Examiner's rejections of the pending claims are improper at least because the Examiner has not provided a proper legal basis for rejecting any claim. Therefore, Appellants respectfully request that the Examiner's rejections be reversed.

If any issues remain, or if there are any suggestions for expediting allowance of the present application, please contact Stephan J. Filipek using the information provided below.

Appellants hereby enclose a Petition for a Two-Month Extension of Time to Respond, and request any other extension of time that may be required to make this Appeal Brief timely. Please charge any fees that may be required for this paper, or credit any overpayment, to Deposit Account No. 50-0271.

July 12, 2007  
Date

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## APPENDIX A

### **CLAIMS INVOLVED IN THE APPEAL**

1. A billing statement comprising:
  - a description of a transaction; and
  - an offer pointer associated with the transaction,
  - wherein the offer pointer comprises information for use to review an offer.
2. A billing statement according to Claim 1, wherein the billing statement comprises a printed document.
3. A billing statement according to Claim 1, wherein the billing statement comprises viewable electronic data.
4. A billing statement according to Claim 1, wherein the offer pointer comprises a Uniform Resource Locator.
5. A billing statement according to Claim 4, wherein the offer pointer further comprises a code for submission to a website referenced by the Uniform Resource Locator.
6. A billing statement according to Claim 5, wherein the code is associated with the offer.

7. A billing statement according to Claim 1, wherein the offer pointer comprises a telephone number.
8. A billing statement according to Claim 7, wherein the offer pointer further comprises a code.
9. A billing statement according to Claim 8, wherein the code is associated with the offer.
10. A billing statement according to Claim 1, wherein the offer pointer is not an offer.
11. A billing statement according to Claim 1, wherein the transaction is one of a plurality of transactions described in the billing statement.
12. A billing statement according to Claim 1, wherein a plurality of transactions are described in the billing statement, and wherein the offer pointer is associated with more than one of the plurality of transactions.
13. A billing statement according to Claim 1, wherein the offer is an offer to reduce an amount owed associated with the transaction.
14. A billing statement according to Claim 1, wherein the offer is an offer to reduce an interest rate on an amount owed.

15. A billing statement according to Claim 1, wherein the offer is an offer to extend a due date by which a minimum due amount is due.

16. A billing statement according to Claim 1, wherein the offer is an offer to eliminate a minimum due amount.

17. A billing statement according to Claim 1, further comprising:  
a second description of a second transaction; and  
a second offer pointer associated with the second transaction,  
wherein the second offer pointer includes second information for use to review a second offer.

18. A billing statement according to Claim 17, wherein the second offer is identical to the first offer.

19. A billing statement according to Claim 1, wherein the offer pointer is located adjacent to the description.

40. A method comprising:  
receiving transaction information;  
determining an offer pointer based on the transaction information, the offer pointer including information for use to review an offer; and  
transmitting the offer pointer to a customer via a billing statement.

41. A method comprising:  
receiving transaction information;  
determining an offer based on the transaction information;  
determining an offer pointer, the offer pointer including information  
for use to review the offer; and  
transmitting the offer pointer to a customer via a billing statement.

42. A method comprising:  
receiving from a customer an offer pointer associated with a  
transaction on a billing statement; and  
transmitting an offer to the customer, the offer being associated with  
the offer pointer.



***APPENDIX B – EVIDENCE***

<NONE>

***APPENDIX C – RELATED PROCEEDINGS***

***<NONE>***